

Application No.: 09/656,581
Reply Dated: July 30, 2004
Action Dated: January 30, 2004

REMARKS

I. SUMMARY

A. Action Digest

In the January 30, 2004 Patent and Trademark Office action issued against the above-referenced application (Action), the Examiner first noted that in view of Applicants' response filed November 6, 2003, the Examiner had determined that there were no public-use or on-sale issues in the current application, and, accordingly thereby, that no public-use or on-sale issues had arisen as a result of Prodigy activity occurring at least before August, 1988 (Action, p. 1). Additionally, the Examiner noted that in view of Applicants' responses filed, respectively, May 23, 2002, and November 6, 2003, the Examiner had determined that the disclosure of Applicants' current application satisfied the Section 112, ¶1 "enablement" requirements of the patent statute for pending claims 1-51 (Action, p. 3).

However, thereafter, while the Examiner acknowledged that the respective disclosures of Applicants' prior applications Serial No. 08/933,500, filed 9/18/97; Serial No. 08/740,043, file 10/23/96; Serial No. 08/158,026 filed 11/23/93; and Serial No. 07/388,156, filed 7/28/89, the filing dates of which Applicants' at least have sought as a matter of right for pending claims 1-51, were substantially the same - the Examiner went on to contend none of those respective disclosures in his opinion satisfied the Section 112, ¶1 "written description" requirement of the patent statute for claims 1-51 (Action, pp. 2-4). Based on that contention, the Examiner denied pending claims 1-51 the filing date of any of Applicants' prior applications (Action, pp. 4-9).

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Having denied pending claims 1-51 the benefit of any of Applicants' prior application respective filing dates, the Examiner then demanded Applicants provide a showing under Section 1.608(b) of the patent rules of practice as to why Applicants should prevail over the Merriman et al. patent (5,948,061) which Applicants have sought to institute an interference with (Action, p. 9).

Yet additionally, upon denying Applicants' pending claims 1-51 the benefit of the filing date of any of Applicants' prior applications, the Examiner: rejected pending claims 1-51 under Section 102(e) of the patent statute as anticipated by the Merriman et al. patent (Action pp. 10-11); rejected pending claims: 1, 3, 7, 13, 15, 19, 20, 23, 29, 32, 34, 38, 41, 43, 47, 48, 50, and 51 under Section 102(b) of the patent statute as anticipated by a publication entitled: *Ubiquitous Advertising on the WWW: Merging Advertisement on the Browser*, by Kohda et al. dated May 26, 1996 (Action, pp. 11-13); and rejected pending claims: 2, 4, 8, 10, 14, 16, 24, 26, 33, 35, 42, 44, 48, and 49 under Section 103(a) of the patent statute as obvious in view of the Kohda et al. publication (Action, pp. 13-15).

Concerning the Examiner's denial of the filing date of any of Applicants' prior applications to pending claims 1-51, the Examiner asserted, without advancing evidentiary support, that the subject matter of claims 1-51 was not described in the specifications of any of Applicants' prior applications in such a way as to reasonably convey to one skilled in the art that the Applicants, at the time the prior applications were filed, had possession of the inventions claimed (Action, pp. 2-3).

In that regard, the Examiner generally asserted that claims 1-12, 13-18, 32-37, 41-46, and 47-49, (Claim Group A) were not entitled to the benefit of the noted prior application filing dates because the "specifications" of the prior applications did not expressly,

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implicitly, or inherently disclose the "simplified embodiment" which Applicants had demonstrated in their reply of May 23, 2002 was taught to those skilled in the art, and which the Examiner acknowledged those specifications enabled. However, in particularly asserting his contention, the Examiner argued only that the simplified system was not inherently disclosed on the grounds that the "high function system," "gateway," and "ADSL0T" elements were not required by Applicants' prior disclosures to operate as described in Applicants' May 23, 2002 reply (Action, pp. 4-7).

As to claims 19-31, 38-40 and 51 (Claim Group B), in denying the right to the filing dates of any prior application, the Examiner again generally asserted that the noted claims were not entitled to any earlier filing dates because the prior applications did not expressly, implicitly, or inherently disclose the claimed subject matter. In that regard, the Examiner contended that the prior applications did not expressly, implicitly, or inherently disclose that the high function system (advertisement host) was responsive to a request from the user reception system based on ADSLOT (the location designator) to select advertising content, and to reply to such a request by identifying the advertising content to the user reception system. In particularizing his contention as to the noted claims, however, the Examiner, argued only that the prior applications did not inherently disclose that: Applicants' high function system received any request from the user reception system because such function was not required from the disclosure, and, that there was no communication link from the user reception system to the high function system. Based on these unsupported assertions, the Examiner concluded, it was not inherent from the prior disclosures that the high function system ever received or responded to an advertisement request from the user reception system as claimed (Action, pp. 7-9).

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As to claim 50, the Examiner, advanced no specific grounds in support of his contention that it was not described in the specifications of any of Applicants' prior applications in such a way as to reasonably convey to one skilled in the art that Applicants, at the time the prior applications were filed, had possession of the claim 50 subject matter.

Concerning the demand for response pursuant to Section 1.608(b) of the patent rules of practice, the Examiner asserted that because the Examiner had denied pending claims 1-51 the benefit of any of Applicants' prior application respective filing dates, the filing date for claims 1-51 was the filing date of the current application; i.e., September 6, 2000, and that the September 6, 2000 filing date was more than 3 months after the filing date of the application that matured into the Merriman et al. '061 patent which patent Applicants seek interference with. The Examiner then asserted that in view of the September 6, 2000 filing date he applied to pending claims 1-51, under Section 1.608(b) Applicants were required to: provide evidence; e.g., patents, publications, other documents, and affidavits or declarations; as well as an explanation which demonstrates that Applicants are entitled to a judgment in an interference with Merriman et al. (Action, p. 9).

As to the Examiner's rejection of Applicants' pending claims 1-51, the Examiner asserted that because the Examiner had denied pending claims 1-51 the benefit of any of Applicants' prior application respective filing dates, thereby imposing on claims 1-51 a filing date of September 6, 2000, claims 1-51 were rejected under Section 102(e) of the patent statute as anticipated by the Merriman et al. patent, the Merriman et al. patent having an application filing date of October 29, 1996. In that regard, the Examiner asserted that Applicants' claims 1-13 were the same as Merriman et al. claims 1-13; Applicants' claims 14-16 were the same as Merriman et al. claims 17-19; Applicants' claims 17-18 were the same as Merriman et al. claims 14-15; Applicants' claim 19 was the same as Merriman et

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al. claim 16; Applicants' claims 20-35 were the same as Merriman et al. claims 20-35; Applicants' claims 36-37 were the same as Merriman et al. claims 40-41; Applicants' claims 38-40 were the same as Merriman et al. claims 42-44; Applicants' claims 41-46 were the same as Merriman et al. claims 1-13; Applicants' claims 47-50 were the same as Merriman et al. claims 36-39; and Applicants' claim 50 was the same as Merriman et al. claim 16.

Regarding the Examiner's rejection of Applicants' pending claims 1, 3, 7, 13, 15, 19, 20, 23, 29, 32, 34, 38, 41, 43, 47, 48, 50, and 51 under Section 102(b), the Examiner asserted that because he had denied pending claims 1-51 the benefit of any of Applicants' prior application respective filing dates, the noted pending claims had a filing date of September 6, 2000, and, the noted pending claims were rejected under Section 102(b) of the patent statute as anticipated by the Kohda et al. publication which had a date of May 26, 1996. Particularly, the Examiner maintained that pending claims 1, 7, 13, 32, 41, and 47 were anticipated by Kohda et al. because Kohda et al. disclosed the subject matter of the noted pending claims, particularly, a network including a user reception system (Fig. 2, browser), a content host (Fig. 2, Web server); an advertiser host (Fig. 2, Advertiser Web server) and an advertisement host (Fig. 2, Advertising agent Web server), wherein advertising content from the selected advertiser host was displayed at the user reception system. Concerning claims 3, 15, 34, 43 and 48, the Examiner maintained Kohda et al. disclosed the selecting of advertising content for presentation to the user based on user characteristics and interests (Action, pp. 11-12). As to pending claims 19, 23, 29, 38, and 51, the Examiner contended Kohda et al. disclosed a user reception system (Fig. 2, browser); a content host (Fig. 2, web server); and an advertisement host (Fig. 2, Advertising agent Web server), responsive to a request from the user reception system to select advertisement content (Fig. 2, advertisement Web page), such that advertising content from the advertisement host was displayed at the user reception system (Action, 12-13). With respect to claims 20 and 50,

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the Examiner asserted Kohda disclosed that the advertisement host identified an advertiser host (Fig.2 Advertiser's Web server) to the user system, and the advertiser host delivered advertisement content to the user reception system (Action, 12-13).

Finally, concerning the Examiner's rejection of Applicants' pending claims 2, 4, 8, 10, 14, 16, 24, 26, 33, 35, 42, 44, 48, and 49 and under Section 103(a) of the patent statute, the Examiner simply asserted that because the Examiner had denied pending claims 1-51 the benefit of any of Applicants' prior application respective filing dates, the noted pending claims had a filing date of September 6, 2000, and, the noted pending claims were rejected under Section 103(a) of the patent statute as obvious in view of the Kohda et al. publication which had a date of May 26, 1996. With respect to claims 2, 8, 14, 24, 33, 42, and 49, the Examiner acknowledged that Kohda et al. did not disclose selecting an advertiser host based on the number of time the advertising content has been previously display. However, without showing more, the Examiner asserted it would have been obvious for one skilled in the art to display the advertisement based on the number of time previously display because "it would have enable rotation of the advertisement and to fulfill the display rate contracted with the advertiser " (Action, p. 14).

With respect to claims 4, 10, 16, 26, 35, 44 and 48, the Examiner admitted that Kohda et al. did not disclose the user-characteristic limitations recited in the noted claims for selecting advertisements. However, without offer of proof, the Examiner asserted that the type of user characteristics recited in the noted claims for selecting an advertisement would have been a matter of design choice because "it ... [did] not functionally affect the method for retrieving and displaying of the advertisement of claim 17. [And,] [i]t would have been obvious for one of ordinary skill in the art to choose one or more characteristics that would enable appropriate matching of the advertisements to the current user" (Action, p. 14).

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B. Reply Digest

1. Overview

Applicants would respectfully submit that the express teaching of at least their great-great-grandparent application, serial number 388,156 filed July 28, 1989, now issued as U.S. patent 5,347,032 ('156 application), comprehends; i.e., embraces, the "simplified" approach to delivery of user-targeted ads; and that the simplified approach to delivery of user targeted ads is, in fact, expressly included in, and, an applicant-devised precursor of the preferred, "pre-fetch"; i.e., buffered, approach presented in their '156 application, the principal elements of the simplified approach; i.e., user reception systems 400 exclusive of the pre-fetch buffer; high function system 110; and gateway system 210 being the same in structure and function as in the pre-fetch approach - stated otherwise - the simplified approach is, in fact, a part of Applicants' invention of the pre-fetch approach, the pre-fetch buffer being preferred in, but, not essential to, the ability to deliver targeted ads, and, that teaching would have been clearly understood by those skilled in the network art and considered possessed by Applicants at the time Applicants' filed the '156 application - thereby - rendering the written description of the '156 application, which written description is carried forward in all subsequent applications, adequate under the law to make at least the filing date of the '156 application, available to the current application and its claimed subject matter. In support of those conclusions, Applicants offer as evidence the respective disclosures of their prior applications and the content of *Data and Computer Communications*, by William Stallings, Macmillian Publishing Company (1985) which is incorporated by reference in Applicants' '156 application and subsequent applications, the Stallings book also being offered in its entirety in this reply as evidence of skill in the art indicating comprehension by those skilled in the art that based on Applicants' '156 disclosure, the simplified approach was in Applicants' possession at the time of filing of the '156 application on July 28, 1989, a copy of the Stallings book being attached hereto and

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made a part hereof. Accordingly, Applicants further submit that the Examiner's denial of Applicants' '156 application's filing date to the current application and its claimed subject matter is improper and must be withdrawn.

Prior to introduction of the Prodigy Interactive Service for which Applicants' inventive work was undertaken, because of display limitations, ads presented in interactive applications were required to be written directly into the application content; i.e., hard-coded with the application content. Accordingly, such ads could not be independently targeted to users, but rather, could be qualified for delivery based only on the content of respective applications. However, Applicants believed ads targeted to the characteristics of respective service users would likely be more favorably received by users than ads whose presentation could be conditioned only on application content - that is - regardless of whether the application content was of interest to the user or not, if ads were sympathetic to the user, Applicants believed, the user would be more likely to act on the ads so targeted and presented.

Therefore, Applicants undertook to innovate a network architecture and service operation that enabled the displaying at respective user reception systems of user-targeted ads independently of the interactive application content the ads were displayed with.

Still further, to facilitate the supplying of application-independent, user-targeted ads to respective user reception systems for display with service applications, Applicants also developed network facilities and procedures for delivering the targeted ads, those facilities and procedures including elements for establishing user-targeted ad information and delivering that information to respective user reception systems.

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As would be appreciated by those skilled in the art at the time Applicants' '156 application was filed, the pre-fetch; i.e., buffered, approach is but one form of ad delivery, albeit denominated as preferred, *but*, expressly reserved as subject to modification (i.e., Applicants note in the '156 disclosure that: "[w]hile this invention has been described in its preferred form, it will be appreciated that changes may be made in the form, construction, procedure and arrangement of its various elements and steps without departing from its spirit or scope." ('156 discl. col. 4, lns. 5-7). However, simplified delivery; i.e., non-pre-fetched delivery, that is, non-buffered delivery, is also and equally embraced by Applicants; i.e., the simplified approach is, in fact, a part of Applicants' invention of the pre-fetch approach - and - that fact is necessarily communicated to those skilled in the art, upon fulling reading Applicants' '156 disclosure since all that is required to reach the pre-fetch approach from the simplified approach is to add the pre-fetch buffer, which buffer while desirable, is not essential to the ability to deliver targeted ads, the rest of the network architecture and operation remaining the same in structure and function - that is - the principal elements of the simplified approach; i.e., user reception systems 400 exclusive of the pre-fetch buffer; high function system 110; and gateway system 210 are the same in structure and function in the simplified approach as in the pre-fetch approach. Stated otherwise, the simplified approach to ad delivery is included in, and, is an applicant-devised precursor of the pre-fetch approach, the buffer of the pre-fetch being preferred in, not essential to the ability to deliver targeted ads; i.e., the simplified approach is, in fact, a part of Applicants' invention of the pre-fetch approach. Accordingly, the written description of the '156 application, which is carried forward in all of Applicants' following applications, clearly embraces the simplified approach of targeted ad delivery - and - those in the network art having the skill evidenced in at least the Stallings text book, upon reviewing Applicants' '156 patent application at the time the application was

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filed would have so understood that fact since network communication between the elements of the simplified approach and pre-fetch approach remains the same.

Accordingly, in view of the above, it is clear that not only did Applicants pioneer the invention of network architecture and methods for *displaying* application-independent, user-targeted ads in interactive applications, but also, Applicants pioneered invention of network architecture and methods for *delivering* such targeted ads to the user reception system for display, those methods for delivering targeted ads to user reception systems including at least the simplified approach and the pre-fetch approach as above described. Therefore, the Examiner's denial of Applicants' '156 application's filing date to the current application and its claimed subject matter is improper and must be withdrawn.

2. No *Prima Facie* Case Advanced Upon Which to Deny Applicants Right to Prior Application Filing Dates

a. The Examiner has failed to establish a *prima facie* case upon which to deny Applicants' right to the filing date of at least their '156 application because the Examiner has erroneously and incorrectly described Applicants' '156 disclosure and the targeted ad delivery facility there disclosed, and thereby, the Examiner has failed to either demonstrate the claimed subject matter; i.e., the simplified approach to targeted ad delivery, is outside the scope of the '156 disclosure, or, that one of ordinary skill in the art would not have consider the '156 disclosure adequate to support the currently claimed simplified approach to targeted ad delivery. See, *In re Alton*, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996) ("The examiner . . . 'bears the initial burden . . . of presenting a *prima facie* case of unpatentability.' *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Insofar as the written description requirement is concerned, that burden is discharged by 'presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure

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a description of the invention defined by the claims.’ *Wertheim*, 541 F.2d at 263, 191 USPQ at 97 [*In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976)].”). Further, in view of *Alton* and other Federal Circuit authority, the Examiner is obliged to present evidence or reasons why persons skilled in the art would not recognize in at least that the ‘156 application, the disclosure of the simplified approach to targeted ad delivery. And, yet further, in view of that failure, as a matter of law Applicants’ ‘156 written description must be deemed adequate to support the currently claimed simplified approach to targeted ad delivery, and the Examiner’s denial of the ‘156 application’s July 28, 1989 filing date to the current application and claimed simplified approach to targeted ad delivery, must be withdrawn. See *In re Oetiker*, at 1444 citing *In re Grabiak*, 226 USPQ 870, 873 (Fed. Cir. 1985); and *In re Rinehart*, 189 USPQ 143 (CCPA 1976).

b. The Examiner has failed to show that at least Applicants’ ‘156 application does not satisfy the requirements of Section 120 of the patent statute which, in pertinent part, establishes that Applicants are entitled to the filing dates of prior applications that disclose claimed subject matter in accord with Section 112, ¶1 of the patent statute. See, MPEP Section 2163, at 2100-170 (8th ed. 2003), citing *In re Marzocchi* 169 USPQ 367, 379 (CCPA 1971) (An application specification is to be presumed adequate pursuant to Section 112, ¶1 until shown otherwise); compare, *In re Cortright*, 49 USPQ2d 1464, 1466 (Fed. Cir. 1999).

c. The Examiner has failed to offer and declined to provide evidence to support his contention that the written description respectively in Applicants’ ‘156 and following applications are inadequate to support the currently claimed subject matter. Stated otherwise, the Examiner has failed to offer any evidentiary support for his conclusion that the simplified approach to targeted ad delivery is not embraced in Applicants’ ‘156 and following disclosures, and those skilled in the art would not have recognized or

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understood a description of the simplified approach to targeted ad delivery in those disclosures, other than, the Examiner's own, unfounded and erroneous opinions regarding the express content of Applicants' '156 and following disclosures, which opinions, in fact, are not evidence. *See, In re Dembiczak*, 50 USPQ.2d 1614, 1617 (Fed. Cir. 1999) (Board conclusory statement regarding patentability standing alone are not evidence).

d. The Examiner has failed to understand, and, indeed, has mis-described the technological elements expressly taught in the disclosures of Applicants' '156 and following applications, which elements and associated teachings necessarily communicate to and would be understood by those skilled in the art at the time of respective filing of Applicants' '156 and following applications as comprehending and encompassing the currently claimed simplified approach to targeted ad delivery.

For example, and with regard to claims 1-12, 13-18, 32-37, 41-46, and 47-49; (Claim Group A) the Examiner contends the written descriptions of Applicants' prior specifications are inadequate on the grounds that the "simplified," targeted ad delivery approach is not expressly, implicitly, or inherently disclosed - because - "[t]he [prior] specification ... does not ... [suggest] the 'high system function' [sic] selects an advertiser host connected via the gateway 210 to provide advertisement content in response to a request from a user reception system" (Action, p. 6).

In fact, however, Applicants' '156 application disclosures and suggests that high function system 110 receives request messages from respective user reception systems 400 for ad information, and, supplies ad information in response to the requesting reception system 400, that ad information identifying ad content, for example, located across gateway 210, the processing of such ad information originating a message across the gateway 210 for ad content and its supply to the requesting user reception system 400. More

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specifically, Applicants' '156 application indicates a message ('156 discl. col. 22, ln. 29 - col. 23, ln. 46) from a respective reception system 400 requesting ad information is sent to high function system 110 ('156 discl. col. 92, lns. 1-6); and a targeted ad object id is sent in response from high function system 110 to the requesting reception system 400 ('156 discl. col. 92, lns. 6-9), the targeted ad object including ('156 discl. col. 14, lns. 34-44) a "program call segment" ('156 discl. col. 14, ln. 48 - col. 15, ln. 2) having a program including, for example, the interpretive language verb "SEND" ('156 discl. col. 89, lns. 36-53; col. 63, ln. 52 - col. 64, ln. 6) to originate a message, and a verb "RECEIVE" ('156 discl. col. 89, lns. 36-53; col. 62, lns. 27-40) to accept a reply to the message across a gateway ('156 discl. col. 35, ln. 58 - col. 39, ln. 18) for targeted ad content.

Additionally, with regard to Claim Group A, the examiner nakedly contends: "[t]here is no disclosure of what exist [sic] on the outside network [over gateway 210]" (Action, p. 6).

Here, however, not only does the Examiner assert an unfounded and erroneous characterization of what Applicants' '156 application actually does expressly disclose, but also, the Examiner assert and imposes an improper and unauthorized written description test. The written description adequacy test established by the Court of Appeals for the Federal Circuit (discussed fully below) turns *not* on what a specification *expressly* discloses, but rather, on what those skilled in the art conclude the specification embraces, *see, In re Alton*, 37 USPQ2d 1578, 1584 (Fed. Cir. 1996) ("If a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate written description requirement is met."). With regard to the Examiner's erroneous characterization of what Applicants' '156 application actually

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does expressly disclose, the Examiner here erroneously asserts Applicants' '156 application does not include any express disclosure concerning what exists on the other side of described gateway system 210. However, as a reading of Applicants' '156 application clearly shows, Applicants, in fact, expressly state that gateway system 210 connects network 10 "to other sources of information and data; e.g., other computer systems" ('156 discl. col. 4, lns. 35-42). Additionally, Applicants' '156 application expressly states that the Applicants' Data Interchange Architecture (DIA) which support system messaging "provides common data structure between applications run at RS 400 units and applications that may be run on external computer networks; e.g. Dow Jones Services, accessed through gateway 210" ('156 discl. col. 22, lns. 53-57). Still further, Applicants' '156 application expressly teaches that messages passed over gateways 210, "between the network and external parties occurs between two applications; i.e., the server 205 [and a] network message handler (NMH). The server Switch 205 is an application which is written and maintained by network 10 and resides on it. The message handler resides on the other side of gateway 210 from network 10 and may be written and maintained by the external party; i.e., suppliers of information to network 10 such as Dow Jones" ('156 discl. col. 35, ln. 58 - col. 39, ln. 18).

Continuing with regard to Claim Group A, notwithstanding the above-described express disclosure in Applicants' '156 application concerning communication between system elements supporting Applicants' possession of the simplified approach to user-targeted ad delivery as of the filing of their '156 application, the Examiner asserts, without offer of proof, that "[t]here is no written description [in Applicants' prior applications] that a request from the user system is ever received by the 'high function system' 110 or a 'gatewayed' third-party host. Any request for content not already on the

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user system is fulfilled by the cache/concentrator 302 and file server 205" (Action, bottom p. 6 - p. 7).

Here also, the Examiner asserts an improper *express-description* test, instead of the establish what-the-disclosure-embraces-viewed-by-skill-in-the-art test, again, *see, In re Alton*, 37 USPQ2d at 1584 - and - advances unfounded and erroneous descriptions of what Applicants' '156 application, in fact, expressly discloses. As pointed out above, Applicants' '156 application expressly teaches that user reception systems 400 and high function system 110 are network connected and directly communicate with one another at least for the purpose of respective reception systems 400 requesting targeted ad information from high function system 110, and high function system 110 responding by sending user-targeted ad information to the requesting reception system 400 ('156 discl. col. 92, lns. 1-9). Still further, and again, as noted above, Applicants' '156 application expressly teaches that respective user reception systems 400 are network connected and communicate over gateway system 210 with other sources of information and data; e.g., other computer systems ('156 discl. col. 4, lns. 35-42) such as Dow Jones ('156 discl. col. 22, lns. 53-57; col. 35, ln. 58 - col. 39, ln. 18); and that such communication are expressly taught to be capable of arising from advertising objects (ad objects, '156 discl. col. 14, lns. 34-44; program call segments, col. 14, ln. 48 - col. 15, ln. 2) that are capable of initiating messages (SEND, '156 discl. col. 89, lns. 36-53; col. 63, ln. 52 - col. 64, ln. 6) and receiving message responses (RECEIVE, '156 discl. col. 89, lns. 36-53; col. 62, lns. 27-40) across a gateway ('156 discl. col. 35, ln. 58 - col. 39, ln. 18) for targeted ad content.

Still further, the Examiner erroneously asserts with regard to Claim Group A that Applicants' disclosure "teaches away" from the simplified approach because "[t]he

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disclosed system was aimed at solving the issues of low bandwidth and latency in retrieving data over slow modem link at the user reception systems" (Action, p. 6).

This assertion is also unfounded. As pointed out earlier with regard to targeted ads, Applicants' system architecture and operation, *inter alia*, are aimed at displaying application-independent, user-targeted ads at user reception systems 400 because Applicants believed such ads would be more favorably received by users, thus contributing to the likelihood the Service would be commercial successful, ads being a source of commercial support for the Service. As part of the effort to display such ads, a further aim of the Applicants was to deliver the application-independent, user-targeted ads to respective reception systems 400. That "delivery aim" was of prominent importance to the display objective and was addressed by enabling reception systems 400 to receive ad information from; e.g., high function system 110, and gateway system 210, by means of network communication as above and hereafter described. Both the simplified approach and the pre-fetch approach are directed to that aim, in that both the simplified approach and the pre-fetch approach feature network connection and direct communication, again, as above and hereafter described. In fact, the only difference between the simplified approach and the pre-fetch approach is that the pre-fetch approach enhance; i.e., improves, performance by reducing response time with the inclusion of an ad buffer. However, while the buffer is preferred; i.e., desirable, it is not essential to the ability to deliver targeted ads. The two approach share the same network arrangement, and, in fact, the simplified approach is a applicant-devised precursor of the pre-fetch approach. The pre-fetch approach does not "teach away" from the simplified approach, rather it enhances it, and that fact would be clearly appreciated by those skilled in the art.

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With regard to claims 19-31, 38-40 and 51; (Claim Group B), the Examiner, here also without any offer of proof, contends that Applicants' prior specifications do not expressly, implicitly, or inherently disclose the simplified targeted ad delivery approach because "[t]here is no written description suggesting that the 'high function system' 110 ever receive any user request. There is no written description suggesting that the 'high function system' 110 ever receive a user request based a *[sic]* location designation and to response *[sic]* with advertising content" (Action, p. 8).

Once again, the Examiner's asserts are unfounded and erroneous descriptions of what Applicants' '156 application, in fact, expressly describes. As explained above, Applicants' '156 application expressly teaches that user reception systems 400 and high function system 110 are network connected and directly communicate with one another ('156 discl. col. 22, ln. 29 - col. 23, ln. 46) at least for the purpose of respective reception systems 400 requesting targeted ad information from high function system 110, and high function system 110 responding by sending user-targeted ad information to the requesting reception system 400 ('156 discl. col. 92, lns. 1-9). Applicants' '156 disclosure; for example, expressly states:

Whenever the [reception system 400] advertisement queue has more empty positions than replenishment threshold, a transaction is made to the advertisement queue application in high function system 110 shown in FIG. 2, via [reception system 400] object/communications manager interface 433 for a number of advertisement object id's equal to the threshold. A response message [from high function system 110] includes a list of advertisement object id's, which [reception system 400] ad manager 442 enqueues.

'156 Disclosure col. 92, lns. 1-9.

Still further, Applicants' '156 application expressly teaches that in the preferred, pre-fetch; i.e., buffered, approach, the message from a respective reception system 400

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requesting targeted ad information arises from an ADSLOT call occurrence that reduces the pre-fetched; i.e., buffered, ad id supply below a preset value ('156 discl. col. 91, ln. 61 - col. 92, ln. 9). As would be appreciated by those skilled in the art, the ADSLOT call that reduces the ad buffer is the precipitating event that directly causes reception system 400 to message to high function system 110 for ad information - stated otherwise - the ADSLOT call is the event certain that depletes the buffered ad id supply below the preset level and triggers the request message to high function system 110 ('156 discl. col. 91, lns. 61-68). Accordingly, the Examiner's assertions notwithstanding, Applicants' '156 application, in fact, at least suggests that the high function system 110 receive a user request based on an ADSLOT; i.e., location designation, event, and high function system 110, as previously described, responds by sending ad information to the respective reception system 400.

Continuing with regard to Claim Group B, notwithstanding the above-described express disclosure in Applicants' '156 application concerning communication between system elements supporting Applicants' possession of the simplified approach to user-targeted ad delivery as of the filing of their '156 application, the Examiner asserts that "[f]ig. 2 and the disclosure clearly show that the 'high function system' 110 only *[sic]* connected to File server 205. There is no communication link from the user reception system to the 'high function system' 110. All content requests from the user receptions are fulfilled by the cache/connector 302 or server 205." (Action, p. 8).

Here again, the Examiner's assertions regarding the express disclosure of Applicants' prior applications are unfounded and erroneous. Indeed, not only do the Examiners assertions manifest a gross misunderstanding of what Applicants' prior applications actually expressly disclosure, but also, the Examiner's assertions lack an appreciation of basic network communication technology. As pointed out above,

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Applicants' '156 specification expressly discloses and teaches that the elements of Applicants' system elements are network connected and communicate directly ('156 discl. col. 22, ln. 24 - col. 39, ln. 18). As the '156 disclosure states:

In accordance with the invention, to facilitate message exchange internally, and through gateway 210 to entities externally to network 10, a protocol termed the "Data Interchange Architecture" (DIA) is used to support the transport and interpretation of information. More particularly, DIA enables: communications between RS 400 units; separation of functions between network layers 100, 200, 300 and 401; consistent parsing of data; an "open" architecture for network 10; downward compatibility within the network; compatibility with standard industry protocols such as the IBM System Network Architecture; Open Systems Interconnections standard; support of network utility sessions; and standardization of common network and application return codes.

'156 Disclosure, col. 22, lns. 29-59.

Moreover, with regard to the Examiner's reference to Applicants' Fig. 2, as understood by those skilled in the network art, because network communication employing multilayer protocols such as SNA, OSI, TCP/IP and Applicants' DIA rely on use of network addressing and routing, single-wire network diagrams are understood to embrace the existence of direct communication channels between multiple network elements. *See e.g., W. Stallings, Data and Computer Communications,,* included herewith; at least, at chapters 12, 14.

Yet additionally, and as emphasized above, Applicants' '156 disclosure expressly teaches that user reception systems 400 and high function system 110 directly communicate with each another; for example, regarding reception system 400 requests to high function system 110, for ad information and its supply, the '156 disclosure states:

Whenever the [reception system 400] advertisement queue has more empty positions than replenishment threshold, a transaction is made to the advertisement queue application in high function system 110 shown in FIG.

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2, via [reception system 400] object/communications manager interface 433 for a number of advertisement object id's equal to the threshold. A response message [from high function system 110] includes a list of advertisement object id's, which [reception system 400] ad manager 442 enqueues.

'156 Disclosure col. 92, Ins. 1-9.

e. The Examiner has failed to apply and declined to consider the proper legal test for determining the adequacy of a written description for claimed matter under Section 112, ¶1 in connection with a request for the filing date of an earlier application. Instead of applying the standard for a written description adopted and repeatedly articulated by the Court of Appeals for the Federal Circuit (Federal Circuit), *see In re Alton*, 37 USPQ2d 1578, 1584 (Fed. Cir. 1996), the Examiner has applied his own test; i.e., a test that requires for a written description to be adequate, the written description must *expressly describe* the subject matter claimed. However, the Federal Circuit has specifically rejected such an express, written description test as the Examiner asserts, and, rather, has authorized and approved a test that turns on whether a written description conveys to those skilled in the art that the applicants were in possession of the claimed matter as of the application filing date. Specifically, the Federal Circuit has established that a written description is adequate for claimed subject matter where "the applicant ... convey[s] with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed." *See, Vas-Cath Inc. v. Mahurkar*, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). In that regard, Judge Rich speaking for the Federal Circuit in *Vas-Cath* observed:

Since its inception, the Court of Appeals for the Federal Circuit has frequently addressed the "written description" requirement of §112. A fairly uniform standard for determining compliance with the "written description" requirement has been maintained throughout: **"Although [the applicant] does not have to describe exactly the subject matter claimed, ... the description must clearly allow persons of ordinary skill in the art to**

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recognize that [he or she] invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (citations omitted). "[T]he test for sufficiency of support in a parent application is whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)). Our cases also provide that compliance with the "written description" requirement of §112 is a question of fact, to be reviewed under the clearly erroneous standard. *Gosteli*, 872 F.2d at 1012, 10 USPQ2d at 1618; *Utter v. Hiraga*, 845 F.2d 993, 998, 6 USPQ2d 1709, 1714 (Fed. Cir. 1988). (Emphasis added.)

Vas-Cath at 1116. See, also, e.g., *Moba B.V. v. Diamond Automation Inc.*, 66 USPQ2d 1429, 1439 (Fed. Cir. 2003); *Union Oil Co. of Cal. v. Atlantic Richfield Co.*, 54 USPQ2d 1227, 1232 (Fed. Cir. 2000); *In re Alton*, 37 USPQ2d 1578, 1581 (Fed. Cir. 1996).

Still further, in *Vas-Cath*, Judge Rich cut to the heart of written description evaluation for all those cases that went before *Vas-Cath* - and, indeed - all those that have come after. Specifically, he pointed out that written description evaluations are strongly *matters of fact*, and, because of that, are *to be taken on a case-by-case basis* rather than resolved by some prescribed formula. Still further, he emphasized and reiterated the CCPA's view as adopted by the Federal Circuit, that because of controlling influence of factual matters on written description evaluations, little can be taken from decided written description cases. Specifically, in explaining the history of written description evaluation, Judge Rich wrote:

The CCPA's "written description" cases often stressed the fact-specificity of the issue. See, e.g., *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976) ("The primary consideration is factual and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure") (emphasis in original); *In re Smith*, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972) ("Precisely how close the

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description must come to comply with §112 must be left to case-by-case development"); *DiLeone*, 438 F.2d at 1405, 168 USPQ at 593 [*In re DiLeone*, 436 F.2d 1404, 168 USPQ 592, (CCPA 1971)] ("What is needed to meet the description requirement will necessarily vary depending on the nature of the invention claimed"). The court even went so far as to state: "it should be readily apparent from recent decisions of this court involving the question of compliance with the description requirement of §112 that each case must be decided on its own facts. Thus, the precedential value of cases in this area is extremely limited." *In re Driscoll*, 562 F.2d 1245, 1250, 195 USPQ 434, 438 (CCPA 1977). (Emphasis added.)

Vas-Cath at 1115. See also, *Union Oil Co. of California v. Atlantic Richfield Co.*, 54 USPQ2d 1227, 1235 (Fed. Cir. 2000) ("*Wertheim* [*supra*] reiterates the often cited rule that written description questions are *intensely factual*, and should be dealt with on a case-by-case basis, without the application of wooden rules. . . . Thus, *Wertheim* fully supports the result in this case and limits the applicability of *Ruschig*." [*In re Ruschig*, 379 F.2d 990, 154 USPQ 118 (CCPA 1967) (emphasis added)]); *In re Alton*, 37 USPQ2d 1578, 1581 (Fed. Cir. 1996) ("Finally, we have stated that "[p]recisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis." (citation omitted)); *Eiselstein v. Frank*, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) ("The test is whether the disclosure of the application relied upon reasonably conveys to a person skilled in the art that the inventor had possession of the claimed subject matter at the time of the earlier filing date. 'Precisely how close the original description must come to comply with the description requirement of Section 112 must be determined on a case-by-case basis.' " (citation omitted)).

Notwithstanding the Federal Circuits noted standards for the written description inquiry, and its substantially fact-based dependancy, the Examiner, in the current application, however, as pointed out, has improperly asserted and compelled a mandatory, "express disclosure" burden on Applicants, a burden that refuses to consider the particular

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facts of the subject application. For example, the Examiner has failed to consider the facts concerning the predictable character of the computerized network communication art of the subject invention, or the facts concerning the established understanding of those skilled in the art regarding that technology, or the facts concerning what those skilled in the art would understand any of Applicants' prior applications; e.g., the '156 application, to disclose. Nor has the Examiner considered the facts concerning Applicants express incorporation in their disclosure of understanding in the computerized network communication art as of at least their '156 application filing date with respect to subject matter concerning Applicants' teaching in the form of the Stallings, *Data and Computer Communications*, text. As well, the Examiner has, likewise, failed to consider the facts concerning absence of either concessions or disclaimers by the Applicants regarding any of the subject matter relating to the simplified form or preferred buffered form of the ad delivery system in the Applicants' former and current applications, or during any of their prosecutions in the Patent and Trademark Office or elsewhere.

As well, the Examiner has failed to consider the Federal Circuit has established that for a written description to be adequate, the written description is *not* required to describe every conceivable and possible future embodiment of the invention to make them claimable. See, e.g., *Cordis Corp. v. Medtronic AVE Inc.*, 67 USPQ2d 1876 (Fed. Cir. 2003), where Judge Bryson speaking for the Federal Circuit pointed out:

As our case law makes clear, ... "[a]n applicant is not required to describe in the specification every conceivable and possible future embodiment of his invention." *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1344 [60 USPQ2d 1851] (Fed. Cir. 2001). "A specification may, within the meaning of 35 U.S.C. §112 para. 1, contain a written description of a broadly claimed invention without describing all species that [the] claim encompasses." *Utter v. Hiraga*, 845 F.2d 993, 998 [6 USPQ2d 1709] (Fed. Cir. 1988). (Emphasis added).

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Cordis at 1886. See also, *Amgen Inc. v. Hoechst Marion Roussel Inc.*, 65 USPQ2d 1385, 1395; (Fed. Cir. 2003); *Rexnord Corp. v. Laitram Corp.*, 60 USPQ2d 1851, 1856 (Fed. Cir. 2001); *SRI Int'l v. Matsushita Elec. Corp. of America*, 227 USPQ 577, 586 (Fed. Cir. 1985) (*en banc*).

Still further, the Examiner has failed to consider that where a disclosure describes a single embodiment, the Federal Circuit has established that claimed subject matter can not be construed as being limited to that embodiment, unless so indicated; stated otherwise, the Federal Circuit has established that a written description including a single embodiment is not limited to claims directed only to that single embodiment.

More specifically, Judge Bryson speaking for the Federal Circuit in *Liebel-Flarsheim Co. v. Medrad Inc.*, 69 USPQ2d 1801 (Fed. Cir. 2004), and rejecting the argument that claims are invalid where they are broader than the only embodiment disclosed, noted;

[T]his court has expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment. See *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1091 [68 USPQ2d 1516] (Fed. Cir. 2003); *Apex Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364, 1377 [66 USPQ2d 1444] (Fed. Cir. 2003); *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373 [65 USPQ2d 1865] (Fed. Cir. 2003); *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1204-05 [64 USPQ2d 1812] (Fed. Cir. 2002); *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1327 [63 USPQ2d 1374] (Fed. Cir. 2002); *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1121 n.14 [227 USPQ 577] (Fed. Cir. 1985) (*en banc*). **Even when the specification describes only a single embodiment, the claims of the patent will not be read restrictively unless the patentee has demonstrated a clear intention to limit the claim scope using "words or expressions of manifest exclusion or restriction."** *Teleflex*, 299 F.3d at 1327. (Emphasis added.)

Liebel-Flarsheim. at 1807. Yet additionally, Judge Bryson, after considering further arguments regarding the inability to claim matter beyond the single embodiment disclosed, reiterated and emphasized the Federal Circuit principle earlier noted:

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This case is therefore governed by the principle that “[a]bsent a clear disclaimer of particular subject matter, the fact that the inventor may have anticipated that the invention would be used in a particular way does not mean that the scope of the invention is limited to that context.” *Northrop Grumman Corp. v. Intel Corp.*, 325 F.3d 1346, 66 USPQ2d 1341 (Fed. Cir. 2003) at 1355; *accord Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 67 USPQ2d 1132 (Fed. Cir. 2003) at 1301; *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 63 USPQ2d 1374 (Fed. Cir.2002) at 1328. (Emphasis added.)

Id. at 1809. See, also, e.g., *Lampi Corp. v. American Power Products, Inc.*, 56 USPQ2d 1445, 1455 (Fed. Cir. 2000); *Laitram Corp. v. Cambridge Wire Cloth Co.*, 9 USPQ2d 1289, 1299 (Fed. Cir. 1988); *SRI Int'l v. Matsushita Elec. Corp. of America*, 227 USPQ 577, 586 (Fed. Cir. 1985) (*en banc*).

And, continuing, the Examiner has failed to consider that the Federal Circuit has also established that where a written description does not describe claimed matter in exactly the same terms, the written description is not to be deemed inadequate when one skilled in the art would recognize upon reading the disclosure that the claimed matter reflects what the disclosure indicates has been invented.

In *All Dental Prodx LLC v. Advantage Dental Products Inc.*, 64 USPQ2d 1945 (Fed. Cir. 2002), the Federal Circuit undertook to reiterate the long established principle that for a written description to be adequate it need not describe in the written description subject matter presented in the claims where such matter would be understood by those skilled in the art. Specifically, Judge Lourie in rendering the court’s opinion explained:

Section 112, first paragraph, states, *inter alia*: “The specification shall contain a written description of the invention.” 35 U.S.C. § 112, ¶ 1 (2000). In order to comply with the written description requirement, the specification “need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claimed.”

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Eiselstein v. Frank, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (citing *Vas-Cath*, 935 F.2d at 1562, 19 USPQ2d at 1115, and *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976)).

The application [in this case] ... as originally filed did not contain the phrase "original unidentified mass"; indeed, there is no mention of the starting material's shape or form anywhere in the patent specification. However, the failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented. See *Eiselstein*, 52F.3d at 1039, 34 USPQ2d [1467] at 1470. (Emphasis added.)

All Dental at 1948.

In *Eiselstein v. Frank*, 34 USPQ2d 1467, (Fed. Cir. 1995), Judge Lourie again speaking for the Federal Circuit explained:

In order to determine whether a prior application meets the "written description" requirement with respect to later-filed claims, the prior application need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the earlier date the applicant had invented what is now claimed. *Id.* [*Vas-Cath Inc. v. Mahurkar*, 19 USPQ2d 1111 (Fed. Cir. 1991)] ... at 1116; see *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976) ("[L]ack of literal support ... is not enough ... to support a rejection under Section 112.") The test is whether the disclosure of the application relied upon reasonably conveys to a person skilled in the art that the inventor had possession of the claimed subject matter at the time of the earlier filing date. *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985). "Precisely how close the original description must come to comply with the description requirement of Section 112 must be determined on a case-by-case basis." *Vas-Cath*, 935 F.2d at 1561, 19 USPQ2d at 1116. (Emphasis added.)

Id. at 1470. See, also, e.g., *Moba B.V. v. Diamond Automation Inc.*, 66 USPQ2d 1429, 1439 (Fed. Cir. 2003) (citing *Union Oil Co. of Cal. v. Atlantic Richfield Co.*, 54 USPQ2d 1227, 1232 (Fed. Cir. 2000); *In re Hayes Microcomputer Prods., Inc.*, 25 USPQ2d 1241, 1245 (Fed. Cir. 1992).

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3. Applicants' Parent Disclosures Have an Adequate Section 112, ¶1 Written Description

a. At least the written description of Applicants' '156 application which is carried forward in all of Applicants' following applications is adequate under Section 120 and Section 112, ¶1 of the patent statute to afford its filing date of July 28, 1989 to the current application and its currently claimed subject matter; i.e., the simplified approach to targeted ad delivery. Applicants' '156 written description supports the currently claimed subject matter because the '156 written description comprehends; i.e., embraces, the "simplified" approach to delivery of user-targeted ads; since the simplified approach to delivery of user targeted ads is, in fact, expressly included in, and, an applicant-devised precursor of the preferred, "pre-fetch"; i.e., buffered, approach presented in their '156 application, the principal elements of the simplified approach; i.e., user reception systems 400 exclusive of the pre-fetch buffer; high function system 110; and gateway system 210, being the same in structure and function as in the pre-fetch approach; i.e., the simplified approach is, in fact, a part of Applicants' invention of the pre-fetch approach, the buffer of the pre-fetch approach while being preferred, is not essential to the ability to deliver targeted ads, and, that teaching would have been clearly understood by those skilled in the network art and considered possessed by Applicants at the time Applicants' filed their '156 application.

As would be appreciated by those skilled in the art at the time Applicants' '156 application was filed, the pre-fetch; i.e., buffered, approach to user-targeted ad delivery is but one form of user-targeted ad delivery, which Applicants have described as "preferred," but which, Applicants' have also described as subject to modification by expressly stating in the '156 disclosure that "[w]hile this invention has been described in its preferred form, it will be appreciated that changes may be made in the form,

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construction, procedure and arrangement of its various elements and steps without departing from its spirit or scope" ('156 discl. col. 4, lns. 5-7).

Simplified delivery; i.e., non-pre-fetched; i.e., non-buffered, delivery, is also and equally embraced by Applicants - and - that fact was necessarily communicated to those skilled in the art upon reading Applicants' '156 disclosure at the time it was filed since all that is required to reach the pre-fetch approach from the simplified approach is to add the pre-fetch buffer to the simplified approach - stated otherwise - all that is necessary to reach the simplified approach from the pre-fetch approach is to drop the ad buffer from the pre-fetch approach, the buffer, while preferred, is not essential to the ability to deliver targeted ads. As a proper reading of Applicants' '156 disclosure makes clear, save for the ad buffer elements and procedures themselves, the network architecture and operation remain the same in structure and function with the ad buffer present in the pre-fetch approach, and with the ad buffer out in the simplified approach; i.e., the simplified approach is, in fact, a part of Applicants' invention of the pre-fetch approach.

As seen from the perspective of operation of user reception system 400, high function system 110 and gateway system 210, owing to their network connection and their ability to exchange information and data in accord with Applicants' disclosed use of communication standards; i.e., SNA, OSI (see, e.g., '156 discl. col. 22, ln. 8 - col. 39, ln. 18), these elements remain in direct communication and operate in substantially the way exclusively of the ad buffer, that is, whether the ad buffer is present in the pre-fetch approach, or whether the ad buffer is removed in the simplified approach. And those facts would have been apparent from the express disclosure of '156 application to one skilled in the art at the time the '156 application was filed, since the general operation and capability of communication standards noted in Applicants' '156 disclosure were

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understood by those skilled in the art as evidenced by the teachings disclosed in at least chapters 12 and 14 of *Data and Computer Communications*, by W. Stallings, published in 1985, a copy of which book is attached here to and made a part hereof.

For example, Stallings at chapter 12 describes the concept of network communication protocols (pp. 371-385); layered communication protocols such as OSI (pp. 385-394), the Department of Defense (DOD) Model, including TCP (pp. 395-399, 404-405), and SNA (pp. 400-404). Additionally, at chapter 14, Stallings discusses gateway and other internetworking technology (pp. 437-467). Accordingly, the Stallings teachings evidence the level of skill in the network art regarding the network architecture and associated communication elements and procedures disclosed in Applicants' '156 application, at least with respect to such elements as user reception systems 400, high function 110 and gateway 210, and indicate those skilled in the art would have comprehended from the '156 application that Applicants had possession of the simplified approach to targeted ad delivery as of the '156 application filing on July 28, 2004.

Still further, it is apparent for Applicants' '156 disclosure that Applicants have *not* used any words or expressions demonstrating or indicating an intention to concede, yield or disclaim the simplified approach to targeted ad delivery from use in their system. And, the Examiner has offered no evidence of any such concession or disclaimer by Applicants of the simplified approach. Rather, what Applicants did do in the '156 disclosure was describe what Applicants felt was their preferred approach to ad delivery, while expressly noting that changes to the preferred approach might be made in the form, construction, procedure and arrangement of its various elements and steps without departing from its spirit or scope ('156 discl. col. 4, lns. 5-7).

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Still further, in order for the Examiner to deny Applicants the benefit of the filing date of their '156 application, the Examiner must restrict the claim scope available to Applicants' '156 disclosure to the expressly noted preferred embodiment presented in the '156 disclosure in violation of the prohibition the Federal Circuit has established regarding improper restriction of claim scope to merely the preferred or single embodiment presented in a patent application or to claimed matter including only all features of the disclosed embodiment. Regarding the Federal Circuit prohibition against denying conceivable and possible future embodiment claim scope to an application *see, e.g., Cordis Corp. v. Medtronic AVE Inc.*, 67 USPQ2d 1876, 1886 (Fed. Cir. 2003); *Amgen Inc. v. Hoechst Marion Roussel Inc.*, 65 USPQ2d 1385, 1395; (Fed. Cir. 2003); *Rexnord Corp. v. Laitram Corp.*, 60 USPQ2d 1851, 1856 (Fed. Cir. 2001); *SRI Int'l v. Matsushita Elec. Corp. of America*, 227 USPQ 577, 586 (Fed. Cir. 1985) (*en banc*). Regarding the Federal Circuit prohibition against denying claim scope other than the disclosed preferred embodiment to an application, *see, e.g., Liebel-Flarsheim Co. v. Medrad Inc.*, 69 USPQ2d 1801, 1807 (Fed. Cir. 2004); *Lampi Corp. v. American Power Products, Inc.*, 56 USPQ2d 1445, 1455 (Fed. Cir. 2000); *Laitram Corp. v. Cambridge Wire Cloth Co.*, 9 USPQ2d 1289, 1299 (Fed. Cir. 1988); and *SRI Int'l v. Matsushita Elec. Corp. of America*, 227 USPQ 577, 586 (Fed. Cir. 1985) (*en banc*). And, regarding the Federal Circuit prohibition against denying claim scope other than exactly as described in a disclosure, *see, e.g., All Dental Prodx LLC v. Advantage Dental Products Inc.*, 64 USPQ2d 1945, 1948 (Fed. Cir. 2002); *Eiselstein v. Frank*, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *Moba B.V. v. Diamond Automation Inc.*, 66 USPQ2d 1429, 1439 (Fed. Cir. 2003) (citing *Union Oil Co. of Cal. v. Atlantic Richfield Co.*, 54 USPQ2d 1227, 1232 (Fed. Cir. 2000); and *In re Hayes Microcomputer Prods., Inc.*, 25 USPQ2d 1241, 1245 (Fed. Cir. 1992). Based on the attendant facts in Applicants case, for example, the predictable character of the computerized network communication art of Applicants' subject invention; and the established understanding of those skilled in the art regarding that technology; and the facts

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concerning what those skilled in the art would understand any of Applicants' prior applications; e.g., the '156 application, to disclose; and the facts concerning Applicants express incorporation in their disclosure of understanding in the computerized network communication art as of at least their '156 application filing date with respect to subject matter concerning Applicants' teaching in the form of the Stallings, *Data and Computer Communications*, text; and the facts concerning absence of either concessions or disclaimers by the Applicants regarding any of the subject matter relating to the simplified form or preferred buffered form of the ad delivery system and in view of the noted Federal Circuit case, Applicants' submit that is improper for the Examiner to exclude to at least Applicants' '156 application disclosure claim scope including the simplified approach to targeted ad delivery.

Therefore, Applicants would respectfully submit, that based at least on the preceding discussions, it is apparent that the written description of the '156 application, which is carried forward in all of Applicants' following applications, embraces the simplified approach of targeted ad delivery; i.e., the simplified approach is, in fact, a part of Applicants' invention of the pre-fetch approach - and - those skilled in the network art upon reviewing Applicants' '156 patent application at the time the application was filed would have so understood that fact. Accordingly, Applicants also respectfully submit that the Examiner's denial of Applicants' '156 application's filing date to the current application and its claimed subject matter is improper and must be withdrawn.

4. Demand Under 37 CFR §1.608(b) and Rejections under 35 USC §§ 102, 103 Improper

a. In view of the above discussion regarding the Examiner's erroneous and unfounded factual analysis of Applicants' prior disclosures and the Examiner's mistaken

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application of the law regarding the adequacy of a written description to support claimed subject matter, and Applicants' reply thereto, Applicants would respectfully submit that, as noted, the Examiner's denial of at least Applicants' '156 application July 28, 1989 filing date to the current application and its currently claimed subject matter is improper and must be withdrawn.

Still further, Applicants would respectfully submit that in view of at least the above discussion concerning the Examiner's improper analysis of the availability of Applicants' prior application filing dates, and Applicants' reply, Applicants' current application and its currently claimed subject matter are entitled to at least the July 28, 1989 filing date of Applicants' '156 application. Accordingly, the effective filing date of the Applicants' current application is *not* more than three (3) months *after* the effective filing date of the patent Applicants seek declaration of an interference with, *but rather*, the effective filing date of Applicants' current application is at least *seven (7) years before* the effective filing date of the patent Applicants seek declaration of an interference with. In view of these facts, the Examiner's demand that Applicants submit a showing pursuant to Section 1.608(b) of the patent regulations is improper and must be withdrawn.

Additionally, since the effective filing date of Applicants' current application is at least seven (7) years before the effective filing date of the patent Applicants seek declaration of an interference with, Applicants' rely at least on the July 28, 1989 effective filing date of their '156 application to establish conception and constructive reduction to practice of the currently claimed subject matter. As established by the Court of Claims and Patent appeals, and approved by the Federal Circuit, "the act of filing the United States application has the legal effect of being, constructively at least, a simultaneous conception and reduction to practice of the [claimed] invention." *See Yasuko Kawai v. Metlesics*, 178

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USPQ 158, 162 (CCPA 1973). *See also, Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 87 (Fed. Cir. 1986) ("constructive reduction to practice occurs when a patent application on the claimed invention is filed"). As a result, Applicants would note that there is no need for proof or corroboration of the claimed subject matter. As explained in *Yasuko Kawai*, 178 USPQ at 163, "the written specification in the application is the evidence proving the invention of that which is reduced to practice." In view of this, Applicants in the current application need not provide evidence of either conception or actual reduction to practice. Applicants, therefore, request that an interference be declared between their current application and U.S. patent 5,948,061, and found in Applicants' favor.

b. With regard to the Examiner's rejection of Applicants' pending claims 1-51 pursuant to Section 102 (e) of the patent statute as being anticipated by Merriman et al. U.S. patent 5,948,061, Applicants would respectfully submit that in view of at least the July 28, 1989 effective filing date of there current application and claimed subject matter and Applicants' conception and constructive reduction to practice established as of that effective filing date by virtue of Applicants' '156 application, the Examiner rejection of pending claims 1-51 pursuant to Section 102(e) as being anticipated by Merriman et al. is improper and must be withdrawn.

Concerning the Examiner's rejection of Applicants' pending claims 1, 3, 7, 13, 15, 19, 20, 23, 29, 32, 34, 38 41, 43, 47, 48 50 and 51 pursuant to Section 102(b) as being anticipated by the Kohda et al. article *Ubiquitoussss Advertising on the WWW; Merging Advertisement on the Browse* noted as published in 1996, Applicants would respectfully submit that in view of at least the July 28, 1989 effective filing date of there current application and claimed subject matter by virtue of Applicants' '156 application, the Examiner rejection of pending

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claims 1, 3, 7, 13, 15, 19, 20, 23, 29, 32, 34, 38 41, 43, 47, 48 50 and 51 pursuant to Section 102(b) as being anticipated by Merriman et al. is improper and must be withdrawn.

Finally, as to the Examiner's rejection of Applicants' pending claims 2, 4, 8, 10, 14, 16, 24, 26 33, 35, 42, 44, 49 and 48 pursuant to Section 103(a) of the patent statute as being unpatentable in view of the noted Kohda et al. publication, Applicants would respectfully submit that in view of at least the July 28, 1989 effective filing date of their current application and claimed subject matter, and Applicants' conception and constructive reduction to practice established as of that effective filing date by virtue of Applicants' '156 application, the Examiner rejection of pending claims 2, 4, 8, 10, 14, 16, 24, 26 33, 35, 42, 44, 49 and 48 pursuant to Section 103(a) as being unpatentable in view of the Kohda et al. publication is improper and must be withdrawn.

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II. The Law

A. The Statutory Right to an Earlier Filing Date

A patent applicant's right to claim the filing date of a prior application for a current application and its claimed subject matter, is established by Section 120 of the patent statute, which in pertinent part provides:

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, . . . shall have the same effect, as to such invention, as though filed on the date of the prior application,

35 USC §120 (BNA, 2004).

Section 112, ¶1 of the patent statute referenced in Section 120 provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 USC §112, ¶1 (BNA, 2004).

B. Statutory Interpretation

1. The Elements of §112, ¶1 Control

The Court of Appeals of the Federal Circuit, has maintained that under Sections 120 of the patent statute, for the filing date of a prior patent application to be available to subject matter claimed in a current application, each of the Section 112, ¶1 elements are to be satisfied; i.e., the prior application is to include: a written description of the claimed

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matter; enablement of the claimed matter; and disclosure of the best mode for practicing the claimed matter. For example, in *Chiron Corp. v. Genentech Inc.*, 70 USPQ2d 1321, 1325 (Fed. Cir. 2004), following trial, the lower court entered judgement invalidating plaintiff-patentee Chiron's monoclonal-antibodies claims under Section 102 of the patent statute because none of the invalidated claims were was found entitled to the earlier filing dates of prior patent applications. On Chiron's, appeal, Judge Rader speaking for the Federal Circuit in affirming the lower court's denial of the earlier filing dates pointed out:

[The subject patent] . . . may only claim priority to an earlier application if the earlier application fulfills the requirements of §112, first paragraph. **In turn, that paragraph requires, in part, that the application "shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same."** 35 U.S.C. §112, ¶ 1.

This court has interpreted this passage as setting forth [in part] two requirements: written description and enablement. *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1330 [65 USPQ2d 1385] (Fed. Cir. 2003). (Emphasis added.)

Chiron Corp at 1325. Still further, in *Bayer AG v. Schein Pharmaceuticals Inc.*, 64 USPQ2d 1001 (Fed. Cir. 2002), the Federal Circuit by Judge Clevenger, on affirming the lower court's grant of summary judgement that plaintiff Bayer's patent was entitled under Sections 120 and 112, ¶1, to the earlier filing date of a prior application so as to avoid alleged invalidity under patent statute Section 102(d) for its claims directed to a class of chemical compounds including antibiotic ciprofloxacin, explained:

In the case at hand, Bayer contends that section 120 entitles the '444 patent to the benefit of the August 13, 1981, filing date of its grandparent, the '560 application. However, by its terms, section 120 applies only if the earlier-filed application, in this case the grandparent, complies with the requirements of section 112. *See Dyer v. Field*, 386 F.2d 466, 468 n.3, 156 USPQ 85, 86n.3 (CCPA

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1967). Thus, Bayer may defeat the 102(d) bar on this basis only if the '560 application fulfils the disclosure requirements of section 112.

....

As we have observed on numerous occasions, section 112 contains [in part] both an enablement requirement and a best mode requirement. (citations omitted) The enablement requirement ensures that "a specification shall disclose an invention in such a manner as will enable one skilled in the art to make and utilize it." *In re Gay*, 309 F.2d at 772, 135 USPQ at 315; *accord Spectra-Physics*, 827 F.2d at 1532, 3 USPQ2d at 1742 Because an enabling disclosure by definition turns upon the objective understanding of a skilled artisan, the enablement requirement can be met by reference to the knowledge of one of ordinary skill in the relevant art.

The best mode requirement is "separate and distinct" from enablement and "requires an inventor to disclose the best mode contemplated by him, as of the time he executes the application, of carrying out the invention." *In re Gay*, 309 F.2d at 772, 135 USPQ at 315. Unlike enablement, the existence of a best mode is a purely subjective matter depending upon what the inventor actually believed at the time the application was filed.

Bayer AG at 1005-1006.

2. The Written Description Dominates Disclosure Adequacy

Notwithstanding that a prior application must meet each of the requirements of Section 112, ¶1, to have its filing date available to later-claimed subject matter, because the "written description" requirement of Section 112, ¶1 is the most demanding - enablement requiring only obviousness to those skilled in the art, and best mode calling only for the inventors belief - cases dealing with the availability of application earlier filing dates to later-claimed subject matter, commonly turn on whether the written description of the application can be considered to include the later-claimed matter. In that regard, the Federal Circuit and its predecessor the Court of Customs and Patent Appeals (CCPA) have consistently held that for the filing date of an application to be available to later-claimed matter, the application written description; i.e., its disclosure, is required to communicate

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to those skilled in the art that as of the application earlier filing date, the applicant had "possession" of the later-claimed matter. As expressed by the leading case in this area, "the test for sufficiency of support . . . is whether the disclosure of the application relied upon reasonably conveys to the artisan [at the time the application was filed] that the inventor had possession . . . of the later claimed subject matter." (internal quotation marks and citations omitted). *Vas-Cath Inc. v. Mahurkar*, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). More specifically, in speaking for the Federal Circuit in *Vas-Cath*, Judge Rich explained:

Since its inception, the Court of Appeals for the Federal Circuit has frequently addressed the "written description" requirement of §112. A fairly uniform standard for determining compliance with the "written description" requirement has been maintained throughout: **"Although [the applicant] does not have to describe exactly the subject matter claimed, . . . the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed."** *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (citations omitted). **"[T]he test for sufficiency of support in a parent application is whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'"** *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)) (emphasis added).

Id. See also, e.g., *Noelle v. Lederman*, 69 USPQ2d 1508, 1513 (Fed. Cir. 2004) ("The written description requirement has been defined many times by this court, but perhaps most clearly in *Vas-Cath*."); *Moba B.V. v. Diamond Automation Inc.*, 66 USPQ2d 1429, 1439 (Fed. Cir. 2003) ("The test for compliance with §112 has always required sufficient information in the original disclosure to show that the inventor possessed the invention at the time of the original filing." (citation omitted)); *All Dental Prodx LLC v. Advantage Dental Products Inc.*, 64 USPQ2d 1945, 1948 (CA FC 2002) ("In order to comply with the written description requirement, the specification 'need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that

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as of the [filing] date the applicant had invented what is now claimed.’ ” (citation omitted)); *Union Oil Co. of California v. Atlantic Richfield Co.*, 54 USPQ2d 1227, 1232 (Fed. Cir. 2000), (“The written description requirement does not require the applicant ‘to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.’ Thus, Section 112, Para. 1 ensures that, as of the filing date, the inventor conveyed with reasonable clarity to those of skill in the art that he was in possession of the subject matter of the claims.” (citations omitted)); *Lampi Corp. v. American Power Products, Inc.*, 56 USPQ2d 1445, 1455 (Fed. Cir. 2000) (“In order to satisfy the written description requirement, the disclosure as originally filed need not provide *in haec verba* support for the claimed subject matter at issue. The requirement is met if ‘the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.’ ” (citations omitted)); *In re Alton*, 37 USPQ2d 1578, 1581 (Fed. Cir. 1996), (“In order to meet the adequate written description requirement, the applicant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but ‘the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.’ Put another way, ‘the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention.’ ” (citations omitted)); *Eiselstein v. Frank* 34 USPQ2d 1467, 1470 (Fed. Cir. 1995), (“In order to determine whether a prior application meets the ‘written description’ requirement with respect to later-filed claims, the prior application need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the earlier date the applicant had invented what is now claimed.’ The test is whether the disclosure of the application relied upon reasonably conveys to a person skilled in the art that the inventor had possession of the claimed subject matter at the time of the earlier filing date.” (citations omitted).”).

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3. Written Description Evaluations are Matters of Fact to be Decided on a Case-by-Case Basis

Still further, in *Vas-Cath*, Judge Rich cut to the heart of written description evaluation for all those cases that went before *Vas-Cath* - and, indeed - all those that have come after. Specifically, he pointed out that written description evaluations are strongly *matters of fact*, and, because of that, they are *to be taken on a case-by-case basis* rather than resolved by some prescribed formula. Still further, he emphasized and reiterated the CCPA's view as adopted by the Federal Circuit, that because of controlling influence of factual matters on written description evaluations, little can be taken from decided written description cases. Specifically, in explaining the history of written description evaluation, Judge Rich wrote:

The CCPA's "written description" cases often stressed the fact-specificity of the issue. See, e.g., *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976) ("**The primary consideration is factual and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure**") (emphasis in original); *In re Smith*, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972) ("**Precisely how close the description must come to comply with §112 must be left to case-by-case development**"); *DiLeone*, 438 F.2d at 1405, 168 USPQ at 593 [*In re DiLeone*, 436 F.2d 1404, 168 USPQ 592, (CCPA 1971)] ("**What is needed to meet the description requirement will necessarily vary depending on the nature of the invention claimed**"). The court even went so far as to state: "**it should be readily apparent from recent decisions of this court involving the question of compliance with the description requirement of §112 that each case must be decided on its own facts. Thus, the precedential value of cases in this area is extremely limited.**" *In re Driscoll*, 562 F.2d 1245, 1250, 195 USPQ 434, 438 (CCPA 1977). (Emphasis added.)

Vas-Cath at 1115. See also, e.g., , *Union Oil Co. of California v. Atlantic Richfield Co.*, 54 USPQ2d 1227, 1235 (Fed. Cir. 2000) ("*Wertheim* [*supra*] reiterates the often cited rule that written description questions are intensely factual, and should be dealt with on a case-by-case basis, without the application of wooden rules. . . . Thus, *Wertheim* fully

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supports the result in this case and limits the applicability of *Ruschig*.” [In *re Ruschig*, 379 F.2d 990, 154 USPQ 118 (CCPA 1967)]; In *re Alton*, 37 USPQ2d 1578, 1581 (Fed. Cir. 1996) (“Finally, we have stated that “[p]recisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis.” (citation omitted)); *Eiselstein v. Frank*, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (“The test is whether the disclosure of the application relied upon reasonably conveys to a person skilled in the art that the inventor had possession of the claimed subject matter at the time of the earlier filing date. ‘Precisely how close the original description must come to comply with the description requirement of Section 112 must be determined on a case-by-case basis.’ ” (citation omitted)).

Continuing, with regard to the substantial impact of factual elements on the outcome of written description cases, the Federal Circuit and CCPA have held that, facts concerning the technological character of the claimed matter and knowledge in the relevant art influence the degree of explicitness; i.e., expressness, required in a written description. Where the technology exhibits uncertainty or imprecision of teaching, the written description is required to more expressly describe the claimed subject matter than in more definite arts, since less reliance can be placed on skill in uncertain arts to explain matter missing or unexplained in an application’s written description. Stated otherwise, in cases where the technology is speculative; e.g., biotechnology and chemistry, as compared with cases concerning more predictable and definite technologies such as the mechanical and electronic arts, the artisan is less able to envision the scope of the disclosed teaching. Accordingly, the written description evaluations in cases concerning uncertain technologies are distinguishable on their facts from cases concerning more predictable technologies.

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Additionally, the Federal Circuit has indicated facts regarding an inventor's failure to show understanding in the art for matter not expressly described in an application can impact written description adequacy evaluation, that is, where the applicant asserts matter not expressly disclosed in an application would be understood by the artisan, an effort to show the understanding in the art is called for. As a result, written description evaluations in cases where there has been little or no consideration of skill in the art are distinguishable on their facts from cases where understanding of the subject matter by those skilled in the art can be shown.

Still further, the Federal Circuit has indicated that facts concerning concession or disclaimer of subject matter in the written description or prosecution history can cause a prior application's written description to be deemed inadequate to support later claims to such matter. Accordingly, written description evaluations in cases where the applicant has expressly conceded or disclaimed subject matter are distinguishable on their facts from cases where the applicant has made no express disclaimer or concession of later-claimed subject matter.

a. Cases Where the Factual Elements of Technology and Knowledge in the Art Dictate Outcome

With regard to cases where the Federal Circuit has noted technological or skill-in-the-art facts have impacted written description evaluation, in *Noelle v. Lederman*, 69 USPQ2d 1508 (Fed. Cir. 2004), a biotechnology interference case, the Federal Circuit approved a Patent and Trademark Office (PTO) written description interpretation effectively limited to the express disclosure of a prior application so as to deny an earlier filing date and foreclose other disclosure support to certain claimed matter, thereby, exposing that claimed matter to rejection in view of intervening prior art because, as the

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PTO asserted, persons of ordinary skill in the art lacked reasonable expectation of success of obtaining the claimed matter; i.e., certainty of outcome, given the state of the biotechnology art at the time.

More specifically, *Noelle v. Lederman* concerned an interference relating generally to vertebrate immune systems; e.g., the immune systems of mammals, and, particularly, to the CD40CR monoclonal antibody, useful in treating hyperactive immune systems that causes allergic reactions and autoimmune diseases. Noelle was the junior party and named inventor on a patent application including claims directed to the CD40CR antibody in various forms; e.g., "generic," "mouse," and "human." Noelle also claimed the hybridoma 4 cell lines for making the CD40CR antibody. Lederman was the senior party and named inventor on an issued patent having claims directed to the human form of the CD40CR antibody (5c8 antibody). Lederman also claimed a hybridoma cell line for making the 5c8 monoclonal antibody.

When the PTO declared the interference it established one count. That count was identified as the human CD40CR antibody of Lederman patent claim 1, *or* the Noelle patent application CD40CR "mouse" antibody of claim 42 *or* the CD40CR "genus" antibody of claim 51. Claim 1 of the Lederman' patent and Claim 52 of the Noelle application were directed to the "human" form of the CD40CR antibody. In disposing of interference motions the PTO Board of Patent Appeals and Interferences (Board) determined, *inter alia*, that Noelle's grandparent application, which Noelle claimed the filing date of, did not have an adequate express written description to support claims for the genus or human form of the CD40CR antibody, and denied the earlier filing date to Noelle's genus and human antibody claims in the current; i.e., interference, application. Thereafter, the Board rejected the Noelle genus and human antibody claims in Noelle's interference application as

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anticipated by intervening prior art. However, the Board determined that Noelle's mouse antibody claim was supported in the express written description of the grandparent application, rendering the grandparent earlier filing date available to that subject matter. The Board cited *Regents of the University of California v. Eli Lilly & Co.* 43 USPQ2d 1398 (Fed. Cir. 1997) for the proposition that an adequate written description of a DNA sequence claim required a precise definition, such as structure, formula, chemical name, or physical properties.

In the proceedings, Noelle argued that those skilled in the art would have been able to recognize the human antibody from Noelle's multiple, expressly described methods for making the mouse antibody - thereby entitling Noelle's genius and human antibody claims to the grandparent earlier filing date despite lack of express description. However, the Board held that one skilled in the art would not have had a reasonable expectation of success of isolating human CD40CR antibodies given the mouse form of CD40CR antigen.

In affirming the Board's determination, and its observations regarding the limiting effect of technological uncertainty on written description evaluation, Judge Gajarsa speaking for the Federal Circuit, after reciting the *Vas-Cath* general proposition that to obtain an earlier filing date, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, the applicant was in possession of the claimed subject matter, Judge Gajarsa went on to point out that where an earlier application describes later-claimed *genetic* material; i.e., matter relating to biotechnology, only by a statement of function or result, that description might not be sufficient to meet the written description requirement, citing *Regents, supra*. In that regard, Judge Gajarsa explained the Federal Circuit had held in the field of biotechnology, that a description of DNA requires a precise definition, such as by structure, formula, chemical name, or

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physical properties. As a result, Judge Gajarsa noted the Federal Circuit had held that statements in the specification describing the functional characteristics of a DNA molecule or methods of its isolation *do not* adequately describe a particular claimed DNA sequence. Instead, in the biotechnology art, an adequate written description of DNA requires more than a statement that the DNA structure is part of the invention and reference to a potential method for isolating that structure. Rather, Judge Gajarsa explained what is required in the biotechnology art, is a description of the DNA itself. Further, Judge Gajarsa pointed out the Federal Circuit in *Vas-Cath* had warned that each case involving the issue of written description, must be decided on its own facts. Thus, Judge Gajarsa continued by once again pointing out that the precedential value of cases in the written description area is "extremely limited," citing *Vas-Cath*. See, *Noelle v. Lederman*, 69 USPQ2d 1508, 1513 (Fed. Cir. 2004). See also, *University of California v. Eli Lilly and Co.* 43 USPQ2d 1398, 1404 (Fed. Cir. 1997) ("An adequate written description of a DNA, such as the cDNA of the recombinant plasmids and microorganisms of the '525 patent, "requires a precise definition, such as by structure, formula, chemical name, or physical properties," not a mere wish or plan for obtaining the claimed chemical invention. Accordingly, "an adequate written description of a DNA requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it; what is required is a description of the DNA itself." (citation omitted)).

On the other hand, where the claim technology is more certain and predictable as in the mechanical and electronic arts, the Federal Circuit has indicated that greater reliance can be placed on knowledge in the art to supplement a written description so as to find a written description adequate to support claimed matter. For example, in *All Dental Prodx LLC v. Advantage Dental Products Inc.*, 64 USPQ2d 1945 (Fed. Cir. 2002), the contested claims concerned a method for making a custom dental impression mold; i.e., a method for

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making a mechanical device. The written description of the subject patent taught that the process for making the mold could be improved by using less expensive materials and reducing the time it was applied to the patient. Particularly, the written description taught that the material proposed, polycaprolactone, after being heated to the point of pliability, could be comfortably molded directly over a person's teeth, without the need for a tray or container. The written description further explained that after cooling to body temperature, the polycaprolactone mold would be rigid, thus forming an impression. The lower court construed the key phrase appearing in the claims, "original unidentified mass," to mean "a mass that does not have specific preformed size and shape." Thereafter, the lower court, held the two claims of the patent invalid, *inter alia*, under §112, ¶1 because the written description was deemed inadequate, there being no express definition of the phrase "original unidentified mass" in either the patent specification or the prosecution history.

In reversing the lower court, Judge Lourie, speaking for the Federal Circuit, explained:

Advantage [the patentee] contends that, while the phrase "original unidentified mass" does not literally appear in the specification, one skilled in the art would recognize and know how to practice the claimed invention using "an original unidentified mass" upon reading the specification.

. . . .

We [the Federal Circuit] agree with Advantage that there are no genuine issues of material fact concerning whether its patent claims comply with the written description requirement of section 112, first paragraph. **While the contested language is not a model of clarity, it is also fairly simple and intelligible, capable of being understood in the context of the patent specification. It is thus reasonably clear what the invention is and that the patent specification conveys that meaning.**

Section 112, first paragraph, states, *inter alia*: "The specification shall contain a written description of the invention." 35 U.S.C. § 112, ¶ 1 (2000). **In order to comply with the written description requirement, the specification "need**

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not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claimed." *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (citing *Vas-Cath*, 935 F.2d at 1562, 19 USPQ2d at 1115, and *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976)).

... [T]he failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented. *See Eiselstein*, 52 F.3d at 1039, 34 USPQ2d at 1470. Here, the invention involves heating a mass of thermoplastic material that lacks an identifiable form. That invention is described in the specification, albeit not *in haec verba*. . . . We therefore conclude that there are no genuine issues of material fact that the specification describes the claimed invention within the meaning of the statute. Thus, summary judgment of invalidity for failure to satisfy the written description requirement was erroneous and is therefore reversed. (Emphasis added.)

All Dental at 1948. *See also, In re Hayes Microcomputer Products Inc.*, 25 USPQ2d 1241, 1245-46 (Fed. Cir. 1992) ("We [the Federal Circuit] agree that the specification meets the [written description] requirements of section 112, first paragraph recognizing that the specification is directed to one skilled in the art. *See Chemcast Corp. v. Arco Indus. Corp.*, 913 F.2d 923, 926, 16 USPQ2d 1033, 1036 (Fed. Cir. 1990) ('Of necessity, the disclosure required by section 112 is directed to those skilled in the art.'). There is substantial evidence in the record to support the conclusion that one skilled in the art would understand that the timing means of the invention is incorporated into the structure of the microprocessor. . . . One skilled in the art would know how to program a microprocessor to perform the necessary steps described in the specification [written description]. **Thus, an inventor is not required to describe every detail of his invention. An applicant's disclosure obligation varies according to the art to which the invention pertains. Disclosing a microprocessor capable of performing certain functions is sufficient to satisfy the requirement of section 112,**

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first paragraph, when one skilled in the relevant art would understand what is intended and know how to carry it out.” (Emphasis added.)).

b. Cases Where the Factual Element of Showing Understanding in the Art Dictates Outcome

As noted, the Federal Circuit has indicated facts regarding an inventor’s failure to show understanding in the art for matter not expressly described in an application can impact written description adequacy evaluation, that is, where the applicant asserts matter not expressly disclosed in an application would be understood by the artisan, an effort to show the understanding in the art is called for. As a result, written description evaluations in cases where there has been little or no consideration of skill in the art are distinguishable on their facts from cases where understanding of the subject matter by those skilled in the art can be shown.

For example, in *University of Rochester v. G.D. Searle & Co.*, 69 USPQ2d 1886, 1895, 1897 (Fed. Cir. 2004), Rochester appealed the decision of the Western District Court of New York granting summary judgment that Rochester’s asserted patent concerning a method for identifying drugs that could act as an anti-inflammatory, while reducing undesirable gastrointestinal side effects was invalid because of failing to comply with the written description requirement of 35 U.S.C. § 112, ¶ 1. On hearing the appeal, the Federal Circuit affirmed. Specifically, Judge Lourie speaking for the Federal Circuit explained:

[I]t is undisputed that . . . Rochester’s ‘850 patent [at issue] does not disclose any compounds that can be used in its claimed methods. The claimed methods thus cannot be practiced based on the patent’s specification, even considering the knowledge of one skilled in the art. No compounds that will perform the claimed method are disclosed, nor has any evidence been shown that such a compound was known.

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In sum, because the [written description of the] '850 patent does not provide any guidance that would steer the skilled practitioner toward compounds that can be used to carry out the claimed methods – an essential element of every claim of that patent – and has not provided evidence that any such compounds were otherwise within the knowledge of a person of ordinary skill in the art at the relevant time, Rochester has failed to raise any question of material fact whether the named inventors disclosed the claimed invention. Accordingly, we affirm the district court's grant of [defendant] Pfizer's motion for summary judgment [of claim invalidity because of an inadequate written description under Section 112, ¶1]. (Emphasis added).

University of Rochester at, 1895, 1897. See also, *Hyatt v. Boone*, 47 USPQ2d 1128, 1131-32 (Fed. Cir. 1998); ("We [the Federal Circuit] have not been shown clear error in the Board's findings as to the content of the written description . . . **the missing subject matter [from the written description] was not shown to be part of the prior art that would be understood as part of the description of the subject matter of the count.**" (Emphasis added.)); and *Lockwood v. American Airlines Inc.*, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997) ("Lockwood argues that all that is necessary to satisfy the description requirement is to show that one is "in possession" of the invention. Lockwood accurately states the test, see *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), **but fails to state how it is satisfied.**" (Emphasis added.)).

As with the presence of favorable facts concerning certainty of technology and knowledge in the art above noted, once facts demonstrating understanding in the art for matter suggest in a written description are present in a case, the outcome of the written description adequacy evaluation changes dramatically. For example, in *Union Oil Co. of California v. Atlantic Richfield Co.* 54 USPQ2d 1227 (Fed. Cir. 2000), following trial, the jury determined sufficient evidence had been presented to conclude that the contested patent's written description was adequate to support claims for automotive gasoline compositions

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that reduced automobile tailpipe emissions; i.e. the plaintiff patentees' were found in possession of the claimed subject matter as of the application filing date in accord with the requirements of Section 112, ¶1. The defendant infringers, however, upon having their motion to set the jury verdict aside denied, appealed the lower court outcome. In the appeal, the defendants asserted the written description of the subject patent did not fully and expressly described the subject matter of the asserted claims, thereby, causing the written description to be inadequate and the claims invalid. In affirming the lower court's denial of the defendants motion to set aside the jury verdict, Judge Rader speaking for the Federal Circuit pointed out:

The written description requirement does not require identical descriptions of claimed compounds, but it requires enough disclosure in the patent to show one of skill in this art that the inventor "invented what is claimed." *Vas-Cath*, 935 F.2d at 1563. **On this precise question the jury received many days of testimony, heard from skilled refiners, reviewed graphs and claim charts, and examined the patent documents as guided by those skilled in the art. Indeed the district court, which also heard all the evidence from those of skill in the art, stated: "[T]he Court finds that substantial evidence exists in the record regarding written description to support the verdict that Drs. Jessup and Croudace had possession of the claimed subject matter." . . . This court [the Federal Circuit] agrees. Because the record shows substantial evidence of adequate written description for each claim as the jury found, this court affirms [adequacy of the written description].** (Emphasis added.)

Union Oil at 1232, 1235. See also, *Amgen Inc. v. Hoechst Marion Roussel Inc.*, 65 USPQ2d 1385 (Fed. Cir. 2003). In *Amgen*, following a bench trial, the district court, *inter alia*, determined the plaintiff-patentee had provided sufficient evidence to show under Section 112, ¶1, that those skilled in the art would conclude that the applicant had possession of claimed subject matter concerning production of the naturally occurring hormone erythropoietin ("EPO") which controls the formation of red blood cells in bone marrow, and therefore, the written description of a subject patent adequately supported the claims at issue. On appeal, the

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defendant potential infringer contended the subject written description was inadequate to support the asserted claims and, that those claims, accordingly, were invalid under Section 112, ¶1. In affirming the district court's written description determination, Judge Michael speaking for the Federal Circuit pointed out:

... [T]he [district] court weighed the testimony and found that the evidence showed that the [written] descriptions adequately described to those of ordinary skill in the art in 1984 the use of the broad class of available mammalian and vertebrate cells to produce the claimed high levels of human EPO in culture. . . . In so doing, the court credited in particular the testimony of [plaintiff patentee] Amgen's expert, Dr. Harvey Lodish, who testified, among other things, that there might be "minor differences" in applying the method of the disclosed examples (utilizing ... monkey cells) to any vertebrate or mammalian cells, **but that those of ordinary skill could "easily" figure out those differences in methodology.**

....

[Regarding defendant appellant's] argument that [patentee] Amgen failed [in its written description] to sufficiently describe all vertebrate and mammalian cells as engineered in the claimed invention ... [w]e held in *Eli Lilly* that the adequate description of claimed DNA requires a precise definition of the DNA sequence itself — not merely a recitation of its function or a reference to a potential method for isolating it. 119 F.3d at 1566-67, 43 USPQ2d at 1406 More recently, in *Enzo Biochem*, we clarified that *Eli Lilly* did not hold that all functional descriptions of genetic material necessarily fail as a matter of law to meet the written description requirement; rather, the requirement may be satisfied if in the knowledge of the art the disclosed function is sufficiently correlated to a particular, known structure. *See Enzo Biochem*, 296 F.3d at 1324, 63 USPQ2d at 1613. **Both *Eli Lilly* and *Enzo Biochem* are inapposite to this case because the claim terms at issue here are not new or unknown biological materials that ordinarily skilled artisans would easily miscomprehend. Instead, the claims of Amgen's patents refer to types of cells that can be used to produce recombinant human EPO [whose structure is known by those skilled in the art]. Thus, TKT can only challenge the adequacy of disclosure of the vertebrate or mammalian host cell — not the human DNA itself. This difference alone sufficiently distinguishes *Eli Lilly*, because when used, as here, merely to identify types of cells (instead of undescribed, previously unknown DNA sequences), the words "vertebrate" and "mammalian" readily "convey distinguishing information concerning [their] identity" such that one of ordinary skill in the**

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art could "visualize or recognize the identity of the members of the genus." *Eli Lilly*, 119 F.3d at 1567, 1568, 43 USPQ2d at 1406.8 **Indeed, the district court's reasoned conclusion that the specification's description of producing the claimed EPO in two species of vertebrate or mammalian cells adequately supports claims covering EPO made using the genus vertebrate or mammalian cells, renders *Eli Lilly* listless in this case. *Amgen*, 126 F.Supp.2d at 149, 57 USPQ2d at 1507. (Emphasis added.)**

Amgen at 1397, 1398.

c. Cases Where the Factual Element of Subject Matter Concession or Disclaimer Dictates Outcome

As well and as above noted, the Federal Circuit has indicated that facts concerning concession or disclaimer of subject matter in the written description or prosecution history can cause a prior application's written description to be deemed inadequate to support later claims to such matter. Accordingly, written description evaluations in cases where the applicant has expressly disclaimed or repudiated subject matter are distinguishable on their facts from cases where the applicant has made no express disclaimer or concession of later-claimed subject matter.

As an illustration, in *New Railhead Manufacturing LLC v. Vermeer Manufacturing Co.*, 63 USPQ2d 1843 (Fed. Cir. 2002), New Railhead, the owner of a first patent directed to a drill bit for horizontally drilling rock formations, used, for example, when installing utilities around immovable objects such as roadways, rivers, or lakes, and a second patent directed to a method for the horizontally drilling rock formation, the method, in effect, concerning only use of the drill bit, sued Vermeer et al. under both patents for Vermeer et al's manufacture and distribution of a competing drill bit. The New Railhead applications for the respective patents were filed as continuations-in-part that sought the earlier filing date of a provisional application - the right to the earlier filing date being dependent on the provisional application having an adequate written description under

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Section 112, ¶1 to support the later-claimed subject matter. The claims of the New Railhead patents, respectively, featured, *inter alia*: the drill bit being disposed at an angle to the centerline of a mounting housing, and the resulting orbital, intermittent motion of the bit arising in use as a result of the bit mounting. The district court determined that the angled mounting of the bit, and accordingly, the motion in use, were not expressly described in the provisional specification; and, though New Railhead asserted the claimed angulation features could be determined from the provisional drawing which were prepared to scale, the drill-bit inventor, who was also a New Railhead co-owner, *conceded* in a pre-trial deposition that one skilled in the art could *not* determine the claimed angulation feature from the drawings - the inventor's concession being further admitted by two witnesses at trial who were skilled in the art.

The district court, in response to the defendants summary judgement motion following the close of discovery, held that the drill bit patent was invalid because the provision application filing date was unavailable since the provisional written description did not support the bit angulation mounting feature, and because the drill bit claims were anticipated by intervening art. In its holding, the district court found the drill-bit inventor had conceded; i.e., admitted, that the provisional application did not support the bit angulation mounting, and that his later contrary declaration submitted in opposition to partial summary judgment could not, as a matter of law, create a genuine issue of material fact on that point. Additionally, the district court found that New Railhead allowed repeated use of the procedures claimed in the method patent to test, among other things, the durability of the New Railhead drill bits, and that use constituted public, rather than experimental use more than a year before the method continuation-in-part effective filing date, thereby, rendering the method patent invalid.

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In affirming the district court's summary judgment invalidity determination of the New Railhead patents, Judge Michel speaking for the Federal Circuit explained:

We discern no error in the district court's conclusion that this [bit mounting angulation] claim limitation was not adequately supported by the provisional, as the factual bases girding its conclusion are so solid that no reasonable jury could find otherwise. **The district court relied in particular on the admissions [i.e., concessions] in the deposition testimony of Cox [the drill-bit inventor] himself, in which he explained that he knew the drawings contained the heel-toe angle because he understood the configuration of the device, not necessarily because the drawings showed such a configuration.** In addition to Cox's testimony, the district court had before it the testimony of Joseph Steele, the New Railhead employee responsible for the company's research and development (and the person aside from Cox most familiar with the patented drill bit), who averred that he could not tell from the drawings in the provisional whether the heel and toe of the drill bit extended beyond the sonde housing. Randy Runquist, a designer and engineer for Vermeer testified that he, too, was unaware of the angled features of the drill bit from the provisional drawings. (Emphasis added.)

New Railhead at 1846.

Further, in *Gentry Gallery, Inc. v. Berkline Corp.*, 45 USPQ2d 1498 (Fed. Cir. 1998), the Federal Circuit found that because the inventor of patented subject matter had conceded in his patent specification the restricted scope of his claimed invention, specifically, a sectional sofa having a center console positioned between two recliner unit, the controls for the recliner units being located *only* on the console, his written description could *not* be read to support claims of any greater scope; e.g., claimed location of the recliner controls at other than the sofa center console. More specifically, patent owner Gentry sued Berkline in the Massachusetts District Court for infringing Gentry's patent concerning the noted sectional sofa having the controls for the sofa recliners located *only* on the center console. In response, Berkline consolidated with the Massachusetts infringement suite, a declaratory

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judgment action it earlier brought in the Middle District Court of North Carolina to have the Gentry patent declared not infringed and invalid; additionally, Berkline added a counterclaim asserting that the Gentry patent was unenforceable because of inequitable conduct. In the "first round" the Mass. District Court held, *inter alia*, that Berkline did not infringe the Gentry patent either literally or by equivalents, the accused Berkline sofa not including the Gentry claimed "fixed console" in view of limiting statements made by Gentry's inventor during pendency of the Gentry patent application. Thereafter, Berkline asked that the court to determine the patent invalidity and unenforceability issues, which in the "second round" the court agreed to do, and which the court, after a bench trial, did do, determining that Berkline did not satisfactorily prove alleged obviousness, inadequate written description or unenforceability. Accordingly, Gentry appealed, *inter alia*, the district court's judgment holding that Berkline did infringe the Gentry patent, and Berkline cross-appealed the decision that the patent was not shown to be invalid for obviousness, or an inadequate written description, or was not shown to be unenforceable.

On the appeals, the Federal Circuit, *inter alia*, affirmed the district court's determination that Berkline, did not infringe the Gentry claims and that the Gentry claims were not invalid as obvious, but, reversed the districts court's determination that the Gentry patent claims were not invalid for an inadequate written description. Regarding the reversal for an inadequate written description, the Federal Circuit explained that in its patent application disclosure, Gentry had conceded that a principle feature of its patented invention was location of the recliner controls *only* on the center console. As a result, the Federal Circuit held that because of the expressly restricted teaching of the Gentry disclosure, the written description would not support claims not including the conceded limitation. Specifically, in noting the specific facts of the case relied on for the determination, Judge Lourie speaking for the Federal Circuit pointed out:

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In this case, the original disclosure clearly identifies the console as the *only* possible location for the controls. It provides for only the most minor variation in the location of the controls, noting that the control "may be mounted on top or side surfaces of the console rather than on the front wall . . . without departing from this invention." '244 patent, col. 2, line 68 to col. 3, line 3. No similar variation beyond the console is even suggested. Additionally, the only discernible purpose for the console is to house the controls. As the disclosure states, identifying the only purpose relevant to the console, "[a]nother object of the present invention is to provide . . . a console positioned between [the reclining seats] that accommodates the controls for both of the reclining seats." *Id.* at col. 1, ll. 33-37. Thus, locating the controls anywhere but on the console is outside the stated purpose of the invention. Moreover, consistent with this disclosure, Sproule's [Gentry's inventor] broadest original claim was directed to a sofa comprising, *inter alia*, "control means located upon the center console to enable each of the pair of reclining seats to move separately between the reclined and upright positions."

Gentry Gallery at 1503.

However, like the factual elements above-noted, where the factual elements of concession or disclaimer are otherwise; i.e., are not present in a case concerning support for claimed matter, the written description adequacy evaluation outcome is substantially different from those cases where the factual elements of concession or disclaimer are present. Accordingly, in causes concerning written description adequacy evaluation, cases including factual elements of concession or disclaimer of claimed matter are distinguished as *not* having precedential value for cases where facts of concession or disclaimer are not present. Reference to several cases where absence of concession or disclaimer of claimed matter are a factual component illustrates the point.

For example, in *Cordis Corp. v. Medtronic AVE Inc.*, 67 USPQ2d 1876, (Fed. Cir. 2003), the Delaware district court denied defendant AVE's motion for judgement as a

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matter of law that two asserted patents of plaintiff Cordis concerning slotted, balloon-expandable tubular stents used for treatment of coronary artery disease were invalid, the district court having denied the AVE invalidity motion as to one patent on the merits, and as to the other, for not having been properly raised. In its defense to the patent it properly advanced invalidity against, AVE contended: the inventor had limited the asserted claims with the patent's disclosed, limited embodiment; all asserted claims included the restriction "a plurality of slots formed [in the [stent] wall surface]," as construed by the district court; and that construction according to AVE rendered the claims invalid since the embodiment of the patent's written description supported only a particular configuration of full and half slots located in the stent body, *viz.*, a combination of "complete slots"; i.e., slots bounded on all four sides, and half-slots, with the half-slots located only at the ends of each tubular stent body. The district court, however, held the written description had not restricted the "plurality-of-slots" limitation to half slots or complete slots, or any combination of the two. Nonetheless, though the district court, did not grant defendant AVE's invalidity motion, it did grant AVE's motion for summary judgement of no literal infringement, and AVE's motion for judgement as a matter of law of no infringement by equivalents. Faced with the district court's decision, Cordis appealed, *inter alia*, the determinations of noninfringement, and AVE cross-appealed, *inter alia*, the determination of no invalidity.

On appeal, the Federal Circuit sustained the district court's denial of AVE's invalidity motion, and, reversed and remanded the determination of no literal infringement, no infringement by equivalents and the district court's claim construction. In its holding, the Federal Circuit pointed out, *inter alia*, that the district court's claim construction was unsupported and that AVE had not shown that the embodiment of the asserted patents had limited the Cordis available claims scope. The Federal Circuit

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determined that despite the fact that the disclosed preferred embodiment described use of "slots" in a particular arrangement to makeup the preferred form of a vascular stint, there was no limitation of the stint invention to the described preferred embodiment - and accordingly - notwithstanding the preferred embodiment configuration, the claims supportable by the written description could not be limited to the preferred embodiment. Specifically, Judge Bryson, speaking for the Federal Circuit explained:

We conclude that the record supports a finding that [defendant-appellant] AVE failed to prove that the written description requirement was not satisfied in this case. . . .

It is true that the preferred embodiment detailed in the written description contains alternating complete and half-slots at the ends of the tubular members. **As our case law makes clear, however, "[a]n applicant is not required to describe in the specification every conceivable and possible future embodiment of his invention."** *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1344 [60 USPQ2d 1851] (Fed. Cir. 2001). **"A specification may, within the meaning of 35 U.S.C. §112 para. 1, contain a written description of a broadly claimed invention without describing all species that [the] claim encompasses."** *Utter v. Hiraga*, 845 F.2d 993, 998 [6 USPQ2d 1709] (Fed. Cir. 1988).

This case is thus analogous to *Lampi Corp. v. American Power Products, Inc.*, 228 F.3d 1365, 1378 [56 USPQ2d 1445] (Fed. Cir. 2000), in which we upheld the district court's conclusion that the written description was sufficient to support half-shells that are not identical when the patent drawings only showed identical half-shells. We stated that "[i]t is a familiar principle of patent law that a claim need not be limited to a preferred embodiment" and that the "drawings in the patent are merely a 'practical example' of the invention." *Id.*

AVE cites *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473 [45 USPQ2d 1498] (Fed. Cir. 1998), to support its cross-appeal. In *Gentry Gallery*, we concluded that the written description requirement was not satisfied because while "the original disclosure clearly identifies the console as the *only* possible location for the controls," the claims did not limit the location of the control to the console. *Id.* at 1479. *Gentry Gallery* thus applied the

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"proposition that a broad claim is invalid when the entirety of the specification clearly indicates that the invention is of a much narrower scope." *Cooper Cameron Corp. v. Kvaerner Oilfield Prod., Inc.*, 291 F.3d 1317, 1323 [62 USPQ2d 1846] (Fed. Cir. 2002). In the present case, the entirety of the specification does not reflect that the invention goes to the narrower scope of a mixture of half and complete slots. Such a mixture was not conveyed as critical to the invention nor was it described as the only feasible design in the disclosure. Rather, as in *Johnson Worldwide Associates, Inc. v. Zebco Corp.*, 175 F.3d 985, 993 [50 USPQ2d 1607] (Fed. Cir. 1999), "the patent disclosure provides ample support for the breadth of the term []; it does not 'unambiguously limit [] the meaning of [the term]' to the narrower embodiment. (Emphasis added.)

Cordis Corp. at 1886. Compare, e.g., *Golight Inc. v. Wal-Mart Stores Inc.*, 69 USPQ2d 1481 (Fed. Cir. 2004) where in affirming the district courts written description evaluation and associated claim construction in a successful infringement suit, the Federal Circuit by Judge Prost held:

We see no clear definition or disavowal of claim scope in the written description of the [asserted] '989 patent that would limit claim 11 to horizontal rotation through 360°. While it is true that the patentees describe their invention as having the ability to rotate through 360°, this particular advantage is but one feature of the invented search light. The written description describes other significant features as well, such as the use of a particular wireless remote control and differing mechanisms for attaching the search light to the roof of a vehicle. The patentees were not required to include within each of their claims all of these advantages or features described as significant or important in the written description. See *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1370 [67 USPQ2d 1947] (Fed. Cir. 2003) ("An invention may possess a number of advantages or purposes, and there is no requirement that every claim directed to that invention be limited to encompass all of them."); *SRI Int'l*, 775 F.2d at 1121 [*SRI Int'l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 227 USPQ 577, 585 (Fed. Cir. 1985)(*en banc*) ("If everything in the specification were required to be read into the claims, or if structural claims were to be limited to devices operated precisely as a specification-described embodiment is operated, there would be no need for claims.").

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Nor do we find the disclosure of a single embodiment to be limiting in this case. An applicant is not necessarily required by 35 U.S.C. §112, ¶ 1 to describe more embodiments than its preferred one, and we have outright rejected the notion that disclosure of a single embodiment necessarily limits the claims. See *Teleflex*, 299 F.3d at 1327 [*Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 63 USPQ2d 1374 (Fed. Cir. 2002)] (stating that “the number of embodiments disclosed in the specification is not determinative of the meaning of disputed claim terms”). Moreover, “[a]bsent a clear disclaimer of particular subject matter, the fact that the inventor anticipated that the invention may be used in a particular manner does not limit the scope to that narrow context.” *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1301 [67 USPQ2d 1132] (Fed. Cir. 2003).

Thus, we are unpersuaded by [defendant-appellant] Wal-Mart’s contention that the written description compels us to import into claim 11 the requirement of rotation through 360°. (Emphasis added.)

Golight at 1484.

Therefore, based at least on the forging discussion of Federal Circuit and CCPA case law, Judge Rich’s above-noted holding in *Vas-Cath* that written description evaluations are strongly *matters of fact*, and, are *to be taken on a case-by-case basis* rather than resolved by some prescribed formula, is evident. His comments in that regard bear repeating: “ ‘written description’ cases . . . [stress] the fact-specificity of the issue. ‘The primary consideration is factual and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure.’ ‘Precisely how close the description must come to comply with §112 must be left to case-by-case development.’ ‘What is needed to meet the description requirement will necessarily vary depending on the nature of the invention claimed.’ ‘It should be readily apparent . . . that each case must be decided on its own facts.’ Thus, the precedential value of cases in this area is extremely limited.” (citations omitted). *Vas-Cath* at 438.

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4. Requirements of a *Prima Facie* Case of Written Description Inadequacy

As with all matters of patentability, where an assertion is made that claimed subject matter *does not* qualify, the entity making the assert must advance a *prima facie* case in order to compel the proponent of the claimed matter to come forward and justify the grant of rights. In cases concerning the adequacy of a written description to support claimed matter under Section 112, ¶1 of the patent statute, the situation is no different. In that regard, the Federal Circuit has articulated the requirements the U.S. Patent and Trademark Office must meet to make out a *prima facie* case of inadequate written description under Section 112, ¶1; and, the Federal Circuit has done so at least in the case of *In re Alton*, 37 USPQ2d 1578 (Fed. Cir. 1996).

In that case, a Patent and Trademark Office (PTO) examiner first finally rejected claims of an Alton et al. (Alton) application as unpatentable under Sections 102(e) and 103 of the patent statute in view of prior art, the claims concerning an “analog” of human gamma interferon, human gamma interferon being a protein secreted by cells in the human immune system to stimulate immunological activity, the analog having substantially the characteristics of human immune interferon. Alton appealed the examiner’s rejections to the PTO Board of Patent Appeals and Interferences (Board). The Board reversed the rejections, but, thereafter, rejected the Alton claims on new grounds, specifically, under Section 112, ¶1 as unsupported by the application written description. Alton elected to further prosecute the application before the examiner, and submitted a declaration by a Dr. Randolph Wall in opposition to the Board’s Section 112, ¶1 rejection. The examiner, however, finally rejected the Alton claims under Section 112, ¶1 contending the Wall declaration was entitled to little weight, the declaration, in the examiner’s opinion, being directed primarily to matters of law and not fact. Alton again appealed to the Board, which subsequently adopted the examiner’s rejection; i.e., that the Wall declaration would be

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afforded only minimal and inadequate weight to support the subject claims. Thereafter, Alton appealed to the Federal Circuit.

The Federal Circuit, however, reversed the rejection of the examiner as approved by the Board, in a sharply worded opinion that pointed out that the examiner had: misunderstood the significance of the Wall declaration; misunderstood the proper test to be applied in a written description evaluation; and misunderstood the PTO burden in connection with a *prima facie* case concerning alleged inadequacy under Section 112, ¶1 of a written description to support claimed matter.

Speaking for the Federal Circuit, Judge Schall explained that, as pointed out above, to meet the Section 112, ¶1 written description adequacy requirement for support of claimed matter, the applicant is *not* required to provide a particular form of disclosure. Rather, he pointed out, all that is required is the written description communicate to those skilled in the art as of the application filing date that the applicant “possessed” what is claimed. Still further, Judge Schall noted, as also discussed above, that the question of how close the original description is required to come to comply with the written description requirement must be determined on a case-by-case basis. *See, Alton* at 1581.

With regard to the form of an applicant’s disclosure, Judge Schall expressly explained that in the *Alton* case the examiner and Board had failed to appreciate that the Wall declaration constituted factual evidence submitted by Alton which demonstrated that matter deemed missing from the express disclosure of the application written description, was, in fact, understood by those skilled in the art - and - that understanding in the art would work to supplement and bolster the express written description for purposes of finding the written description adequate to support the controverted claimed subject

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matter. Specifically, Judge Schall noted, *inter alia*, that with respect to the Wall declaration, the examiner had asserted: "the Declaration does not point to inherent support or evidence to support the conclusory statement in paragraph 9J [of the Declaration]." *Alton* at 1582. However, thereafter, Judge Schall went on to point out in noting the examiner's action constituted reversible error, *inter alia*, that:

After [controverted] claim 70 was first rejected on section 112, Para. 1 grounds, Alton submitted evidence to rebut the rejection in the form of the Wall declaration. The Wall declaration contained statements of fact directly addressing the issue of whether the specification adequately described the subject matter recited in claim 70. The purpose of the adequate written description requirement is to ensure that the inventor had possession of the claimed subject matter at the time the application was filed. **If a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate written description requirement is met.** For example, in *Ralston Purina Co. v. Far-Mar Co., Inc.*, 772 F.2d 1570, 1576, 227 USPQ 177, 180 (Fed. Cir. 1985), the trial court admitted expert testimony about known industry standards regarding temperature and pressure in "the art of extrusion of both farinaceous and proteinaceous vegetable materials." The effect of the testimony was to expand the breadth of the actual written description since it was apparent that the inventor possessed such knowledge of industry standards of temperature and pressure at the time the original application was filed. Similarly, the Wall declaration in essence attempts to expand the breadth of the specification by arguing that a person of ordinary skill in the art would have understood the two modifications in Example 5 of the specification to be described independently of each other and thus a description of both modifications would include a description of either separately.

The thrust of the examiner's response to the Wall declaration . . . is that the specification *must* describe the precise analog claimed. This explains why the examiner stated that the Wall declaration was inadequate because it *did not* "suggest that the written description in the specification supports an interferon-gamma analog which *must* have the claimed structure." **This argument, however, does not address the point that paragraph 9J of the**

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Wall declaration attempts to make: that one of ordinary skill in the art would have understood the specification to describe the two modifications ... independently and that the description of both modifications together would be relevant as an example of only one of those modifications Thus, according to the Wall declaration, the specification would be understood to describe the relevant modification ... without the irrelevant one. Therefore, according to the Wall declaration, one of ordinary skill in the art would understand Alton to be in possession, in 1983, of the claimed subject matter, which contained the . . . [one] modification but not the [other] modification

The Wall declaration addresses why the claimed subject matter, although not identical to the analog described in the specification, was in Alton's possession. The statement in the examiner's answer that the number of possible analogs encompassed by the specification is substantial does not rebut the thrust of the Wall declaration because the Wall declaration explains why one of ordinary skill in the art would have realized that Alton had possession of one particular analog. **In sum, in his final rejection and again in his Answer, the examiner dismissed the Wall declaration and provided only conclusory statements as to why the declaration did not show that a person skilled in the art would realize that Alton had possession of the claimed subject matter in 1983. (Emphasis added.)**

Alton at 1584.

In view of the Federal Circuit's holding, it is apparent that it is reversible error for the PTO; i.e., examiner or Board, to assert an *express-description* test in assessing written description adequacy to support claimed matter - and that the examiner and/or Board is obliged to consider factual evidence of understanding in the art which may supplement and/or bolster the express written description of an application for purposes of finding the written description adequate to support claimed subject matter.

Continuing, as a further, aspect of the Federal Circuits holding in *Alton*, Judge Schall yet additionally points out that in assessing the adequacy of a written description under

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Section 112, ¶1 to support claimed subject matter the PTO has the burden of making out a *prima facie* case of written description inadequacy. Specifically, Judge Shall on behalf of the Federal Circuit wrote:

The examiner (or the Board, if the Board is the first body to raise a particular ground for rejection) "bears the initial burden . . . of presenting a *prima facie* case of unpatentability." *In re Oetiker* , 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Insofar as the written description requirement is concerned, that burden is discharged by "presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims." *Wertheim*, 541 F.2d at 263, 191 USPQ at 97 [*In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976)]. Thus, the burden placed on the examiner varies, depending upon what the applicant claims. If the applicant claims embodiments of the invention that are completely outside the scope of the specification, then the examiner or Board need only establish this fact to make out a *prima facie* case. *Id.* at 263-64, 191 USPQ at 97. If, on the other hand, the specification contains a description of the claimed invention, albeit not in *ipsis verbis* (in the identical words), then the examiner or Board, in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient. *Id.* at 264, 191 USPQ at 98. Once the examiner or Board carries the burden of making out a *prima facie* case of unpatentability, "the burden of coming forward with evidence or argument shifts to the applicant." *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. To overcome a *prima facie* case, an applicant must show that the invention as claimed is adequately described to one skilled in the art. "After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of the evidence with due consideration to persuasiveness of argument." *Id.* at 1445, 24 USPQ2d at 1444. (Emphasis added.)

Alton at 1583-84. See also, MPEP Section 2163, at 2100-170 (8th ed. 2003), citing *In re Marzocchi* 169 USPQ 367, 379 (CCPA 1971) (Specification of application pursuant to Section 112, ¶1 to be *presumed adequate until shown otherwise*).

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In view of *Alton*, other Federal Circuit authority, and, as well as the Patent and Trademark Office's own Manual of Patent Examining Procedure (MPEP), the PTO examiner and/or Board of Patent Appeals and Interferences, in matters of asserted written description inadequacy under Section 112, ¶1 - and accordingly - rights to earlier filing dates pursuant to Section 120, are obliged to initially present "evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims." *Alton* at 1583, citing *In re Wertheim*. And, yet further, where the examiner or Board is unable to initially do so, the applicant is by law entitled to prevail without showing more. See *In re Oetiker*, at 1444 citing *In re Grabiak*, 226 USPQ 870, 873 (Fed. Cir. 1985); and *In re Rinehart*, 189 USPQ 143 (CCPA 1976).

5. A Written Description Is *Not* Required to Describe Every Conceivable and Possible Future Embodiment of The Invention to Make Them Claimable

In addition to the above-noted Federal Circuit controlling authority concerning the established written description adequacy test, its factual dependance, and the *prima facie* requirements for demonstrating its dissatisfaction, in the course of instituting those principles, the Federal Circuit has also prescribed that for a written description to be adequate, as indicated in the above discussion, the written description is *not* required to describe every conceivable and possible future embodiment of the invention to make them claimable. See, e.g., *Cordis Corp. v. Medtronic AVE Inc.*, 67 USPQ2d 1876 (Fed. Cir. 2003), where Judge Bryson speaking for the Federal Circuit pointed out:

As our case law makes clear, ... "[a]n applicant is not required to describe in the specification every conceivable and possible future embodiment of his invention." *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1344 [60 USPQ2d 1851] (Fed. Cir. 2001). "A specification may, within the meaning of 35 U.S.C. §112 para. 1, contain a written description of a broadly claimed

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invention without describing all species that [the] claim encompasses.”
Utter v. Hiraga, 845 F.2d 993, 998 [6 USPQ2d 1709] (Fed. Cir. 1988). (Emphasis added).

Cordis at 1886. *See also, Amgen Inc. v. Hoechst Marion Roussel Inc.*, 65 USPQ2d 1385, 1395; (Fed. Cir. 2003) (“[O]ur precedent is clear that claims are not perforce limited to the embodiments disclosed in the specification. *E.g., Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1344, 60 USPQ2d 1851, 1856 (Fed. Cir. 2001) (“[A]n applicant is not required to describe in the specification every conceivable and possible future embodiment of his invention.”); *Rexnord Corp. v. Laitram Corp.*, 60 USPQ2d 1851, 1856 (Fed. Cir. 2001) (“Our case law is clear that an applicant is not required to describe in the specification every conceivable and possible future embodiment of his invention. *See SRI Int’l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (*en banc*). “[I]f structural claims were to be limited to devices operated precisely as a specification-described embodiment is operated, there would be no need for claims. Nor could an applicant, regardless of the prior art, claim more broadly than that embodiment.” *Id.*”); *SRI Int’l v. Matsushita Elec. Corp. of America*, 227 USPQ 577, 586 (Fed. Cir. 1985) (*en banc*) (“The law does not require the impossible. Hence, it does not require that an applicant describe in his specification every conceivable and possible future embodiment of his invention. The law recognizes that patent specifications are written for those skilled in the art, and requires only that the inventor describe the “best mode” known at the time to him of making and using the invention. 35 U.S.C. §112.”)

6. A Written Description Including a Single Embodiment Is Not Limited to Claims Directed Only to the Single Embodiment Absent Express Disclaimer.

Still further, the Federal Circuit has also established that where a written description discloses a single embodiment, claimed subject matter based on that disclosure can not be

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construed as being limited to that embodiment, unless so indicated; stated otherwise, the Federal Circuit has established that a written description including a single embodiment is not limited to claims directed only to that single embodiment.

More specifically, Judge Bryson speaking for the Federal Circuit in *Liebel-Flarsheim Co. v. Medrad Inc.*, 69 USPQ2d 1801 (Fed. Cir. 2004), and rejecting the argument that claims are invalid where they are broader than the only embodiment disclosed, noted;

[T]his court has expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment. See *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1091 [68 USPQ2d 1516] (Fed. Cir. 2003); *Apex Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364, 1377 [66 USPQ2d 1444] (Fed. Cir. 2003); *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373 [65 USPQ2d 1865] (Fed. Cir. 2003); *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1204-05 [64 USPQ2d 1812] (Fed. Cir. 2002); *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1327 [63 USPQ2d 1374] (Fed. Cir. 2002); *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1121 n.14 [227 USPQ 577] (Fed. Cir. 1985) (en banc). Even when the specification describes only a single embodiment, the claims of the patent will not be read restrictively unless the patentee has demonstrated a clear intention to limit the claim scope using "words or expressions of manifest exclusion or restriction." *Teleflex*, 299 F.3d at 1327. (Emphasis added.)

Liebel-Flarsheim. at 1807. Yet additionally, Judge Bryson, after considering further arguments regarding the inability to claim matter beyond the single embodiment disclosed, reiterated and emphasized the Federal Circuit principle earlier noted:

This case is therefore governed by the principle that "[a]bsent a clear disclaimer of particular subject matter, the fact that the inventor may have anticipated that the invention would be used in a particular way does not mean that the scope of the invention is limited to that context." *Northrop Grumman Corp. v. Intel Corp.*, 325 F.3d 1346, 66 USPQ2d 1341 (Fed. Cir. 2003) at 1355; accord *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 67 USPQ2d 1132 (Fed. Cir. 2003) at 1301; *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 63 USPQ2d 1374 (Fed. Cir. 2002) at 1328. (Emphasis added.)

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Id. at 1809. *See, also, e.g., Lampi Corp. v. American Power Products, Inc.*, 56 USPQ2d 1445, 1455 (Fed. Cir. 2000); ("It is a familiar principle of patent law that a claim need not be limited to a preferred embodiment. *See Laitram Corp. v. Cambridge Wire Cloth Co.*, 863 F.2d 855, 865, 9 USPQ2d 1289, 1299 (Fed. Cir. 1988) The drawings in the patent are merely a "practical example" of the invention."); *Laitram Corp. v. Cambridge Wire Cloth Co.*, 9 USPQ2d 1289, 1299 (Fed. Cir. 1988); ("That the inventor preferred and adopted commercially a square shaft, because keys tend to fall out of keyed shafts, is not a basis for limiting claim 1 to square or polygonal shafts. References to a preferred embodiment, such as those often present in a specification, are not claim limitations. *SRI Int'l. v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121, 227 USPQ 577, 589 [sic 586] (Fed. Cir. 1985) (in banc). Such reference is thus not a basis here for limiting "noncircular" to square or regular polygonal shafts."); *SRI Int'l. v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121, 227 USPQ 577, 586 (Fed. Cir. 1985) (en banc); ("We may take it that, as the statute [§112, ¶1] requires, the specification . . . show a way of using the inventor's method and that he conceived that particular way described was the best one. But he is not confined to that particular mode of use since the claims of the patent, not its specifications, measure the invention. *Paper Bag Patent Case*, 210 U.S. 405, 419; *McCarty v. Lehigh Valley R. Co.*, 160 U.S. 110, 116; *Winans v. Denmead*, 15 How. 330, 343. . . . As one of our predecessor courts stated in *Autogiro Co. of America v. United States*, 384 F.2d 391, 398, 155 USPQ 697, 703 (Ct. Cl. 1967): The specification "set[s] forth the best mode contemplated by the inventor of carrying out his invention." 35 U.S.C. § 112. This one embodiment of the invention does not restrict the claims.").

7. Is Not Fatal to a Written Description That it Does Not Describe Claimed Matter in Exactly the Same Terms

And, continuing, the Federal Circuit has also established that where a written description does not describe claimed matter in exactly the same terms, the written

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description is not to be deemed inadequate when one skilled in the art would recognize upon reading the disclosure that the claimed matter reflects what the disclosure indicates has been invented.

In *All Dental Prodx LLC v. Advantage Dental Products Inc.*, 64 USPQ2d 1945 (Fed. Cir. 2002), the Federal Circuit undertook to reiterate the long established principle that for a written description to be adequate it need not describe in the written description subject matter presented in the claims where such matter would be understood by those skilled in the art. Specifically, Judge Lourie in rendering the court's opinion explained:

Section 112, first paragraph, states, *inter alia*: "The specification shall contain a written description of the invention." 35 U.S.C. § 112, ¶ 1 (2000). In order to comply with the written description requirement, **the specification "need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claimed."** *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (citing *Vas-Cath*, 935 F.2d at 1562, 19 USPQ2d at 1115, and *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976)).

The application [in this case] ... as originally filed did not contain the phrase "original unidentified mass"; **indeed, there is no mention of the starting material's shape or form anywhere in the patent specification. However, the failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.** *See Eiselstein*, 52 F.3d at 1039, 34 USPQ2d at 1470. (Emphasis added.)

All Dental at 1948.

In *Eiselstein v. Frank*, 34 USPQ2d 1467, (Fed. Cir. 1995), Judge Lourie again speaking for the Federal Circuit pointed out:

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In order to determine whether a prior application meets the "written description" requirement with respect to later-filed claims, the prior application need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the earlier date the applicant had invented what is now claimed. *Id.* [*Vas-Cath Inc. v. Mahurkar*, 19 USPQ2d 1111 (Fed. Cir. 1991)] . . . at 1116; see *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976) ("[L]ack of literal support . . . is not enough . . . to support a rejection under Section 112.") The test is whether the disclosure of the application relied upon reasonably conveys to a person skilled in the art that the inventor had possession of the claimed subject matter at the time of the earlier filing date. *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985). "Precisely how close the original description must come to comply with the description requirement of Section 112 must be determined on a case-by-case basis." *Vas-Cath*, 935 F.2d at 1561, 19 USPQ2d at 1116. (Emphasis added.)

Eiselstein. at 1470. See, also, e.g., *Moba B.V. v. Diamond Automation Inc.*, 66 USPQ2d 1429, 1439 (Fed. Cir. 2003) ("The test for compliance with §112 has always required sufficient information in the original disclosure to show that the inventor possessed the invention at the time of the original filing. . . . The possession test requires assessment from the viewpoint of one of skill in the art. *Id.* [*Vas-Cath*, 935 F.2d] at 1563-64 ('the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention') (emphasis in original); *Union Oil Co. of Cal. v. Atlantic Richfield Co.*, 208 F.3d 989, 997, 54 USPQ2d 1227, 1232 (Fed. Cir. 2000) ('The written description requirement does not require the applicant 'to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed') (citation omitted). In *Enzo* [*Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 63 USPQ2d 1609 (Fed. Cir. 2002)] and *Amgen*, [*Amgen Inc. v. Hoechst Marion Roussel Inc.*, 65 USPQ2d 1385, 1397 (Fed. Cir. 2003)] the record showed that the specification that taught one of skill in the art to make and use an invention also convinced that artisan that the inventor possessed the invention. Similarly

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in this case, the *Lilly* [*Regents of the University of California v. Eli Lilly & Co.*, 43 USPQ2d 1398 (Fed. Cir. 1997)] disclosure rule does not require a particular form of disclosure because one of skill could determine from the specification that the inventor possessed the invention at the time of filing.”); *In re Hayes Microcomputer Prods., Inc.*, 25 USPQ2d 1241, 1245 (Fed. Cir. 1992) (“[The applicant] does not have to describe exactly the subject matter claimed, . . . the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed. . . . The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon ‘reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.’ *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) (citations omitted).”).

C. Interference Rights

1. A Party to an Interference can Rely on the Constructive Reduction to Practice and Corroboration Arising from a Prior Application Filing to Conclusively Demonstrate Priority for Claimed Matter

The Federal Circuit has approved and adopted the principal established by the Court of Claims and Patent appeals, that the act of filing a United States patent application has the legal effect of being a simultaneous constructive conception and reduction to practice of the claimed subject matter. *See, e.g., Stevens v. Tamai*, 70 USPQ2d 1765, 1769 (Fed. Cir. 2004) (citing *Hyatt v. Boone*, 47 USPQ2d 1128, 1130, (Fed. Cir. 1998); and *Yasuko Kawai v. Metlesics*, 178 USPQ 158, 162 (CCPA 1973) (“To establish priority, parties may rely on earlier filed applications because conception and constructive reduction to practice of the subject matter described in an application occur when the application is filed.”). As well, *see, Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 87 (Fed. Cir. 1986)

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("constructive reduction to practice occurs when a patent application on the claimed invention is filed"). As a result, and as the Federal Circuit and CCPA have accordingly established, in such situations, the applicant in an interference who demonstrates entitlement to an effective filing date earlier than that of the interference opponent, the applicant need not provide further proof or corroboration of the claimed subject matter. *See, Stevens* at 1769 ("If a party is entitled to rely on an earlier filed application and the specification of that application shows a constructive reduction to practice of the count, no further evidence is needed to prove invention as of the filing date of that application.") As explained in *Yasuko Kawai*, 178 USPQ at 163, "the written specification in the application is the evidence proving the invention of that which is reduced to practice." In view of this, where an applicant in an interference can establish an effective filing prior to the interference opponent, the applicant need not provide evidence of either conception or actual reduction to practice to prevail in the interference.

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III. Applicants Are Entitled at Least to the July 28, 1989 Filing Date of Their Application Serial Number 388,156 (the '156 Application)

A. No *Prima Facie* Case Advanced Upon Which to Deny Applicants Right to Prior Application Filing Dates

1. The Examiner has failed to establish a *prima facie* case upon which to deny Applicants' right to the filing date of at least their '156 application because the Examiner has erroneously and incorrectly described Applicants' '156 disclosure and the targeted ad delivery facility there disclosed, and thereby, the Examiner has failed to either demonstrate the claimed subject matter; i.e., the simplified approach to targeted ad delivery, is outside the scope of the '156 disclosure, or, that one of ordinary skill in the art would not have consider the '156 disclosure adequate to support the currently claimed simplified approach to targeted ad delivery. See, *In re Alton*, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996) ("The examiner . . . 'bears the initial burden . . . of presenting a *prima facie* case of unpatentability.' *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Insofar as the written description requirement is concerned, that burden is discharged by 'presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.' *Wertheim*, 541 F.2d at 263, 191 USPQ at 97 [*In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976)]."). Further, in view of *Alton* and other Federal Circuit authority, the Examiner is obliged to present evidence or reasons why persons skilled in the art would not recognize in at least that the '156 application, the disclosure of the simplified approach to targeted ad delivery. And, yet further, in view of that failure, as a matter of law Applicants' '156 written description must be deemed adequate to support the currently claimed simplified approach to targeted ad delivery, and, the Examiner's denial of the '156 application's July 28, 1989 filing date to the current

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application and claimed simplified approach to targeted ad delivery, must be withdrawn. See *In re Oetiker*, at 1444 citing *In re Grabiak*, 226 USPQ 870, 873 (Fed. Cir. 1985); and *In re Rinehart*, 189 USPQ 143 (CCPA 1976).

2. In view of the Examiner's noted flawed description of the targeted ad delivery facility disclosed in Applicants' '156 application, noted above and hereafter, the Examiner has failed to show that at least Applicants' '156 application does not satisfy the requirements of Section 120 of the patent statute which, in pertinent part, establishes that Applicants are entitled to the filing dates of prior applications that disclose claimed subject matter in accord with Section 112, ¶1 of the patent statute. See, MPEP Section 2163, at 2100-170 (8th ed. 2003), citing *In re Marzocchi* 169 USPQ 367, 379 (CCPA 1971) (An application specification is to be presumed adequate pursuant to Section 112, ¶1 until shown otherwise); compare, *In re Cortright*, 49 USPQ2d 1464, 1466 (Fed. Cir. 1999).

3. The Examiner has failed to offer and declined to provide evidence to support his contention that the written description in Applicants' '156 and following applications are inadequate to support the currently claimed subject matter. Stated otherwise, the Examiner has failed to offer any evidentiary support for his conclusion that the simplified approach to targeted ad delivery is not embraced in Applicants' '156 and following disclosures, and those skilled in the art would not have recognized or understood a description of the simplified approach to targeted ad delivery in those disclosures, other than, the Examiner's own, unfounded and erroneous opinions regarding the express content of Applicants' '156 and following disclosures, which opinions, in fact, are not evidence. See, *In re Dembiczak*, 50 USPQ.2d 1614, 1617 (Fed. Cir. 1999) (Board conclusory statement regarding patentability standing alone are not evidence).

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4. The Examiner has failed to apply and declined to consider the proper legal test for determining the adequacy of a written description for claimed matter under Section 112, ¶1 in connection with a request for the filing date of an earlier application. Instead of applying the standard for a written description adopted and repeatedly articulated by the Court of Appeals for the Federal Circuit (Federal Circuit), *see, In re Alton*, 37 USPQ2d 1578, 1584 (Fed. Cir. 1996) above discussed, the Examiner has applied his own test; i.e., a test that requires for a written description to be adequate, the written description must *expressly describe* the subject matter claimed. However, the Federal Circuit has specifically rejected such an express, written description test as the Examiner asserts, and, rather, has authorized and approved a test that turns on whether a written description conveys to those skilled in the art that the applicants were in possession of the claimed matter as of the application filing date.

For example and as noted earlier in section II, B, 4, above concerning the law relating to requirements of a *prima facie* case for denying rights to prior filing dates pursuant to Sections 120 and 112, ¶1, based on the Federal Circuit holding in *Alton*, it is reversible error for the PTO; i.e., examiner or Board, to assert an *express-description* test in assessing written description adequacy to support claimed matter - and that the examiner and/or Board are obliged to consider factual evidence of understanding in the art which may supplement and/or bolster the express written description of an application for purposes of finding the written description adequate to support claimed subject matter. As the Judge Schall pointed out on behalf of the Federal Circuit concerning the reversible PTO mishandling of the declaration evidence submitted by the applicant to demonstrate adequacy of the subject written description to support claimed matter:

The Wall declaration addresses why the claimed subject matter, although not identical to the analog described in the specification, was in Alton's possession. The statement in the examiner's answer that the number

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of possible analogs encompassed by the specification [disclosure] is substantial does not rebut the thrust of the Wall declaration because the Wall declaration explains why one of ordinary skill in the art would have realized that Alton had possession of one particular analog. **In sum, in his final rejection and again in his Answer, the examiner dismissed the Wall declaration and provided only conclusory statements as to why the declaration did not show that a person skilled in the art would realize that Alton had possession of the claimed subject matter in 1983. (Emphasis added.)**

Alton at 1584.

As the Federal Circuit made clear in *Alton*, the test for assessing the adequacy of a written description to support claimed subject matter is not the express content of the written description, but rather, what the written description conveys to one skilled in the art concerning the applicant's possession of the claimed subject matter.

Still further, the Federal Circuit had maintained as its predecessor the before it had, that a patent application written description adequately supports claimed subject matter where "the applicant ... convey[s] with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed." *See, Vas-Cath Inc. v. Mahurkar*, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). In that regard, Judge Rich speaking for the Federal Circuit in *Vas-Cath* observed:

Since its inception, the Court of Appeals for the Federal Circuit has frequently addressed the "written description" requirement of §112. A fairly uniform standard for determining compliance with the "written description" requirement has been maintained throughout: **"Although [the applicant] does not have to describe exactly the subject matter claimed, ... the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed."** *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (citations omitted). "[T]he

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test for sufficiency of support in a parent application is whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)). (Emphasis added.)

Vas-Cath at 1116. *See, also, e.g., Moba B.V. v. Diamond Automation Inc.*, 66 USPQ2d 1429, 1439 (Fed. Cir. 2003); *Union Oil Co. of Cal. v. Atlantic Richfield Co.*, 54 USPQ2d 1227, 1232 (Fed. Cir. 2000); *In re Alton*, 37 USPQ2d 1578, 1581 (Fed. Cir. 1996).

Still further, in *Vas-Cath*, Judge Rich cut to the heart of written description evaluation for all those cases that went before *Vas-Cath* - and, indeed - all those that have come after. Specifically, he pointed out that written description evaluations are strongly *matters of fact*, and, because of that, are *to be taken on a case-by-case basis* rather than resolved by some prescribed formula. Still further, he emphasized and reiterated the CCPA's view as adopted by the Federal Circuit, that because of controlling influence of factual matters on written description evaluations, little can be taken from decided written description cases. Specifically, in explaining the history of written description evaluation, Judge Rich wrote:

The CCPA's "written description" cases often stressed the fact-specificity of the issue. *See, e.g., In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976) ("**The primary consideration is factual and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure**") (emphasis in original); *In re Smith*, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972) ("**Precisely how close the description must come to comply with §112 must be left to case-by-case development**"); *DiLeone*, 438 F.2d at 1405, 168 USPQ at 593 [*In re DiLeone*, 436 F.2d 1404, 168 USPQ 592, (CCPA 1971)] ("**What is needed to meet the description requirement will necessarily vary depending on the nature of the invention claimed**"). The court even went so far as to state: "it should be readily apparent from recent decisions of this court involving the question of compliance with the description requirement of §112 that each

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case must be decided on its own facts. Thus, the precedential value of cases in this area is extremely limited." *In re Driscoll*, 562 F.2d 1245, 1250, 195 USPQ 434, 438 (CCPA 1977). (Emphasis added.)

Vas-Cath at 1115. *See also, Union Oil Co. of California v. Atlantic Richfield Co.*, 54 USPQ2d 1227, 1235 (Fed. Cir. 2000) ("*Wertheim [supra]* reiterates the often cited rule that written description questions are *intensely factual*, and should be dealt with on a case-by-case basis, without the application of wooden rules. . . . Thus, *Wertheim* fully supports the result in this case and limits the applicability of *Ruschig*." [*In re Ruschig*, 379 F.2d 990, 154 USPQ 118 (CCPA 1967) (emphasis added)]); *In re Alton*, 37 USPQ2d 1578, 1581 (Fed. Cir. 1996) ("Finally, we have stated that "[p]recisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis." (citation omitted)); *Eiselstein v. Frank*, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) ("The test is whether the disclosure of the application relied upon reasonably conveys to a person skilled in the art that the inventor had possession of the claimed subject matter at the time of the earlier filing date. 'Precisely how close the original description must come to comply with the description requirement of Section 112 must be determined on a case-by-case basis.' " (citation omitted)).

Notwithstanding the Federal Circuits noted standards for the written description inquiry, and its substantially fact-based dependancy, the Examiner, in the current application, however, as pointed out, has improperly asserted and compelled a mandatory, "express disclosure" burden on Applicants, a burden that refuses to consider the particular facts of the subject application. For example, the Examiner has failed to consider the facts concerning the predictable character of the computerized network communication art of the subject invention, or the facts concerning the established understanding of those skilled in the art regarding that technology, or the facts concerning what those skilled in the art would understand any of Applicants' prior applications; e.g., the '156 application, to

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disclose. Nor has the Examiner considered the facts concerning Applicants express incorporated in their disclosure of understanding in the computerized network communication art as of at least their '156 application filing date with respect to subject matter concerning Applicants' teaching in the form of the Stallings, *Data and Computer Communications*, text. As well, the Examiner has, likewise, failed to consider the facts concerning absence of either concessions or disclaimers by the Applicants regarding any of the subject matter relating to the simplified form or preferred buffered form of the ad delivery system in the Applicants' former and current applications, or during any of their prosecutions in the Patent and Trademark Office or elsewhere.

As well, the Examiner has failed to consider the Federal Circuit has established that for a written description to be adequate, the written description is *not* required to describe every conceivable and possible future embodiment of the invention to make them claimable. See, e.g., *Cordis Corp. v. Medtronic AVE Inc.*, 67 USPQ2d 1876 (Fed. Cir. 2003), where Judge Bryson speaking for the Federal Circuit pointed out:

As our case law makes clear, ... "[a]n applicant is not required to describe in the specification every conceivable and possible future embodiment of his invention." *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1344 [60 USPQ2d 1851] (Fed. Cir. 2001). **"A specification may, within the meaning of 35 U.S.C. §112 para. 1, contain a written description of a broadly claimed invention without describing all species that [the] claim encompasses."** *Utter v. Hiraga*, 845 F.2d 993, 998 [6 USPQ2d 1709] (Fed. Cir. 1988). (Emphasis added).

Cordis at 1886. See also, *Amgen Inc. v. Hoechst Marion Roussel Inc.*, 65 USPQ2d 1385, 1395; (Fed. Cir. 2003); *Rexnord Corp. v. Laitram Corp.*, 60 USPQ2d 1851, 1856 (Fed. Cir. 2001); *SRI Int'l v. Matsushita Elec. Corp. of America*, 227 USPQ 577, 586 (Fed. Cir. 1985) (*en banc*).

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Still further, the Examiner has failed to consider that where a disclosure describes a single embodiment, the Federal Circuit has established that claimed subject matter can not be construed as being limited to that embodiment, unless so indicated; stated otherwise, the Federal Circuit has established that a written description including a single embodiment is not limited to claims directed only to that single embodiment.

More specifically, Judge Bryson speaking for the Federal Circuit in *Liebel-Flarsheim Co. v. Medrad Inc.*, 69 USPQ2d 1801 (Fed. Cir. 2004), and rejecting the argument that claims are invalid where they are broader than the only embodiment disclosed, noted;

[T]his court has expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment. See *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1091 [68 USPQ2d 1516] (Fed. Cir. 2003); *Apex Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364, 1377 [66 USPQ2d 1444] (Fed. Cir. 2003); *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373 [65 USPQ2d 1865] (Fed. Cir. 2003); *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1204-05 [64 USPQ2d 1812] (Fed. Cir. 2002); *Teleflex, Inc. v. Ficoso N. Am. Corp.*, 299 F.3d 1313, 1327 [63 USPQ2d 1374] (Fed. Cir. 2002); *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1121 n.14 [227 USPQ 577] (Fed. Cir. 1985) (en banc). Even when the specification describes only a single embodiment, the claims of the patent will not be read restrictively unless the patentee has demonstrated a clear intention to limit the claim scope using "words or expressions of manifest exclusion or restriction." *Teleflex*, 299 F.3d at 1327. (Emphasis added.)

Liebel-Flarsheim. at 1807. Yet additionally, Judge Bryson, after considering further arguments regarding the inability to claim matter beyond the single embodiment disclosed, reiterated and emphasized the Federal Circuit principle earlier noted:

This case is therefore governed by the principle that "[a]bsent a clear disclaimer of particular subject matter, the fact that the inventor may have anticipated that the invention would be used in a particular way does not mean that the scope of the invention is limited to that context." *Northrop Grumman Corp. v. Intel Corp.*, 325 F.3d 1346, 66 USPQ2d 1341 (Fed. Cir. 2003) at 1355; accord

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Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc., 334 F.3d 1294, 67 USPQ2d 1132 (Fed. Cir. 2003) at 1301; *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 63 USPQ2d 1374 (Fed. Cir.2002) at 1328. (Emphasis added.)

Id. at 1809. See, also, e.g., *Lampi Corp. v. American Power Products, Inc.*, 56 USPQ2d 1445, 1455 (Fed. Cir. 2000); *Laitram Corp. v. Cambridge Wire Cloth Co.*, 9 USPQ2d 1289, 1299 (Fed. Cir. 1988); *SRI Int'l v. Matsushita Elec. Corp. of America*, 227 USPQ 577, 586 (Fed. Cir. 1985) (*en banc*).

And, continuing, the Examiner has failed to consider that the Federal Circuit has also established that where a written description does not describe claimed matter in exactly the same terms, the written description is not to be deemed inadequate when one skilled in the art would recognize upon reading the disclosure that the claimed matter reflects what the disclosure indicates has been invented.

In *All Dental Prodx LLC v. Advantage Dental Products Inc.*, 64 USPQ2d 1945 (Fed. Cir. 2002), the Federal Circuit undertook to reiterate the long established principle that for a written description to be adequate it need not describe in the written description subject matter presented in the claims where such matter would be understood by those skilled in the art. Specifically, Judge Lourie in rendering the court's opinion explained:

Section 112, first paragraph, states, *inter alia*: "The specification shall contain a written description of the invention." 35 U.S.C. § 112, ¶ 1 (2000). In order to comply with the written description requirement, **the specification "need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claimed."** *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (citing *Vas-Cath*, 935 F.2d at 1562, 19 USPQ2d at 1115, and *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976)).

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The application [in this case] ... as originally filed did not contain the phrase "original unidentified mass"; indeed, there is no mention of the starting material's shape or form anywhere in the patent specification. However, the failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented. See *Eiselstein*, 52F.3d at 1039, 34 USPQ2d [1467] at 1470. (Emphasis added.)

All Dental at 1948.

In *Eiselstein v. Frank*, 34 USPQ2d 1467, (Fed. Cir. 1995), Judge Lourie again speaking for the Federal Circuit explained:

In order to determine whether a prior application meets the "written description" requirement with respect to later-filed claims, the prior application need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the earlier date the applicant had invented what is now claimed. *Id.* [*Vas-Cath Inc. v. Mahurkar*, 19 USPQ2d 1111 (Fed. Cir. 1991)] . . . at 1116; see *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976) ("[L]ack of literal support . . . is not enough . . . to support a rejection under Section 112.") The test is whether the disclosure of the application relied upon reasonably conveys to a person skilled in the art that the inventor had possession of the claimed subject matter at the time of the earlier filing date. *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985). "Precisely how close the original description must come to comply with the description requirement of Section 112 must be determined on a case-by-case basis." *Vas-Cath*, 935 F.2d at 1561, 19 USPQ2d at 1116. (Emphasis added.)

Id. at 1470. See, also, e.g., *Moba B.V. v. Diamond Automation Inc.*, 66 USPQ2d 1429, 1439 (Fed. Cir. 2003) (citing *Union Oil Co. of Cal. v. Atlantic Richfield Co.*, 54 USPQ2d 1227, 1232 (Fed. Cir. 2000); *In re Hayes Microcomputer Prods., Inc.*, 25 USPQ2d 1241, 1245 (Fed. Cir. 1992).

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B. Applicants' Parent Disclosures Have an Adequate Section 112, ¶1 Written Description

1. Applicants would respectfully submit that the express teaching of at least their '156 application, comprehends; i.e., embraces, the "simplified" approach to delivery of user-targeted ads; and that the simplified approach to delivery of user targeted ads is, in fact, expressly included in, and, an applicant-devised precursor of the preferred, "pre-fetch"; i.e., buffered, approach presented in their '156 application, the principal elements of the simplified approach; i.e., user reception systems 400 exclusive of the pre-fetch buffer; high function system 110; and gateway system 210 being the same in structure and function as in the pre-fetch approach - stated otherwise - the simplified approach is, in fact, a part of Applicants' invention of the pre-fetch approach, the pre-fetch buffer being preferred in, but, not essential to, the ability to deliver targeted ads, and, that teaching would have been clearly understood by those skilled in the network art and considered possessed by Applicants at the time Applicants' filed the '156 application - thereby - rendering the written description of the '156 application, which written description is carried forward in all subsequent applications, adequate under the law to make at least the filing date of the '156 application, available to the current application and its claimed subject matter. In support of those conclusions, Applicants offer as evidence the respective disclosures of their prior applications and the content of *Data and Computer Communications*, by William Stallings, Macmillian Publishing Company (1985) which is incorporated by reference in Applicants' '156 application and subsequent applications, the Stallings book also being offered in its entirety in this reply as evidence of skill in the art indicating comprehension by those skilled in the art that based on Applicants' '156 disclosure, the simplified approach was in Applicants' possession at the time of filing of the '156 application on July 28, 1989, a copy of the Stallings book being attached hereto and made a part hereof. Accordingly, Applicants further submit that the Examiner's denial of

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Applicants' '156 application's filing date to the current application and its claimed subject matter is improper and must be withdrawn.

2. Prior to introduction of the Prodigy Interactive Service for which Applicants' inventive work was undertaken, because of display limitations, ads presented in interactive applications were required to be written directly into the application content; i.e., hard-coded with the application content. Accordingly, such ads could not be independently targeted to users, but rather, could be qualified for delivery based only on the content of respective applications. However, Applicants believed ads targeted to the characteristics of respective service users would likely be more favorably received by users than ads whose presentation could be conditioned only on application content - that is - regardless of whether the application content was of interest to the user or not, if ads were sympathetic to the user, Applicants believed, the user would be more likely to act on the ads so targeted and presented.

Therefore, Applicants undertook to innovate a network architecture and service operation that enabled the displaying at respective user reception systems of user-targeted ads independently of the interactive application content the ads were displayed with.

Still further, to facilitate the supplying of application-independent, user-targeted ads to respective user reception systems for display with service applications, Applicants also developed network facilities and procedures for delivering the targeted ads, those facilities and procedures including elements for establishing user-targeted ad information and delivering that information to respective user reception systems.

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As would be appreciated by those skilled in the art at the time Applicants' '156 application was filed, the pre-fetch; i.e., buffered, approach is but one form of ad delivery, albeit denominated as preferred, *but*, expressly reserved as subject to modification (i.e., Applicants note in the '156 disclosure that: "[w]hile this invention has been described in its preferred form, it will be appreciated that changes may be made in the form, construction, procedure and arrangement of its various elements and steps without departing from its spirit or scope." ('156 discl. col. 4, lns. 5-7). However, simplified delivery; i.e., non-pre-fetched delivery, that is, non-buffered delivery, is also and equally embraced by Applicants; i.e., the simplified approach is, in fact, a part of Applicants' invention of the pre-fetch approach - and - that fact is necessarily communicated to those skilled in the art, upon fulling reading Applicants' '156 disclosure since all that is required to reach the pre-fetch approach from the simplified approach is to add the pre-fetch buffer, which buffer while desirable, is not essential to the ability to deliver targeted ads, the rest of the network architecture and operation remaining the same in structure and function - that is - the principal elements of the simplified approach; i.e., user reception systems 400 exclusive of the pre-fetch buffer; high function system 110; and gateway system 210 are the same in structure and function in the simplified approach as in the pre-fetch approach. Stated otherwise, the simplified approach to ad delivery is included in, and, is an applicant-devised precursor of the pre-fetch approach, the buffer of the pre-fetch being preferred in, not essential to the ability to deliver targeted ads; i.e., the simplified approach is, in fact, a part of Applicants' invention of the pre-fetch approach. Accordingly, the written description of the '156 application, which is carried forward in all of Applicants' following applications, clearly embraces the simplified approach of targeted ad delivery - and - those in the network art having the skill evidenced in at least the Stallings text book, upon reviewing Applicants' '156 patent application at the time the application was

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filed would have so understood that fact since network communication between the elements of the simplified approach and pre-fetch approach remains the same.

Accordingly, in view of the above, it is clear that not only did Applicants pioneer the invention of network architecture and methods for *displaying* application-independent, user-targeted ads in interactive applications, but also, Applicants pioneered invention of network architecture and methods for *delivering* such targeted ads to the user reception system for display, those methods for delivering targeted ads to user reception systems including at least the simplified approach and the pre-fetch approach as above described. Therefore, the Examiner's denial of Applicants' '156 application's filing date to the current application and its claimed subject matter is improper and must be withdrawn.

3. At least the written description of Applicants' '156 application which is carried forward in all of Applicants' following applications is adequate under Section 120 and Section 112, ¶1 of the patent statute and the Federal Circuit and CCPA case law concerning adequacy of written descriptions to support claimed matter above described, to afford '156 application filing date of July 28, 1989 to the current application and its currently claimed subject matter. Applicants' '156 written description supports the currently claimed subject matter because the '156 written description comprehends; i.e., embraces, the "simplified" approach to delivery of user-targeted ads; since the simplified approach to delivery of user targeted ads is, in fact, expressly included in, and, an applicant-devised precursor of the preferred, "pre-fetch"; i.e., buffered, approach presented in their '156 application, the principal elements of the simplified approach; i.e., user reception systems 400 exclusive of the pre-fetch buffer; high function system 110; and gateway system 210, being the same in structure and function as in the pre-fetch approach; i.e., the simplified approach is, in fact, a part of Applicants' invention of the pre-fetch approach, the buffer of the pre-fetch

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approach while being preferred, is not essential to the ability to deliver targeted ads, and, that teaching would have been clearly understood by those skilled in the network art and considered possessed by Applicants at the time Applicants' filed their '156 application.

As would be appreciated by those skilled in the art at the time Applicants' '156 application was filed, the pre-fetch; i.e., buffered, approach to user-targeted ad delivery is but one form of user-targeted ad delivery, which Applicants have described as "preferred," but which, Applicants' have also described as subject to modification by expressly stating in the '156 disclosure that "[w]hile this invention has been described in its preferred form, it will be appreciated that changes may be made in the form, construction, procedure and arrangement of its various elements and steps without departing from its spirit or scope" ('156 discl. col. 4, lns. 5-7).

Simplified delivery; i.e., non-pre-fetched; i.e., non-buffered, delivery, is also and equally embraced by Applicants - and - that fact was necessarily communicated to those skilled in the art upon reading Applicants' '156 disclosure at the time it was filed since all that is required to reach the pre-fetch approach from the simplified approach is to add the pre-fetch buffer to the simplified approach - stated otherwise - all that is necessary to reach the simplified approach from the pre-fetch approach is to drop the ad buffer from the pre-fetch approach, the buffer, while preferred, is not essential to the ability to deliver targeted ads. As a proper reading of Applicants' '156 disclosure makes clear, save for the ad buffer elements and procedures themselves, the network architecture and operation remain the same in structure and function with the ad buffer present in the pre-fetch approach, and with the ad buffer out in the simplified approach; i.e., the simplified approach is, in fact, a part of Applicants' invention of the pre-fetch approach.

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As seen from the perspective of operation of user reception system 400, high function system 110 and gateway system 210, owing to their network connection and their ability to exchange information and data in accord with Applicants' disclosed use of communication standards; i.e., SNA, OSI (see, e.g., '156 discl. col. 22, ln. 8 - col. 39, ln. 18), these elements remain in direct communication and operate in substantially the way exclusively of the ad buffer, that is, whether the ad buffer is present in the pre-fetch approach, or whether the ad buffer is removed in the simplified approach. And those facts would have been apparent from the express disclosure of '156 application to one skilled in the art at the time the '156 application was filed, since the general operation and capability of communication standards noted in Applicants' '156 disclosure were understood by those skilled in the art as evidenced by the teachings disclosed in at least chapters 12 and 14 of *Data and Computer Communications*, by W. Stallings, published in 1985, a copy of which book is attached here to and made a part hereof.

For example, Stallings at chapter 12 describes the concept of network communication protocols (pp. 371-385); layered communication protocols such as OSI (pp. 385-394), the Department of Defense (DOD) Model, including TCP (pp. 395-399, 404-405), and SNA (pp. 400-404). Additionally, at chapter 14, Stalling discusses gateway and other internetworking technology (pp. 437-467). Accordingly, the Stallings teachings evidence the level of skill in the network art regarding the network architecture and associated communication elements and procedures disclosed in Applicants' '156 application, at least with respect to such elements as user reception systems 400, high function 110 and gateway 210, and indicate those skilled in the art would have comprehended from the '156 application that Applicants had possession of the simplified approach to targeted ad delivery as of the '156 application filing on July 28, 2004.

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Still further, it is apparent for Applicants' '156 disclosure that Applicants have *not* used any words or expressions demonstrating or indicating an intention to concede, yield or disclaim the simplified approach to targeted ad delivery from use in their system. And, the Examiner has offered no evidence of any such concession or disclaimer by Applicants of the simplified approach. Rather, what Applicants did do in the '156 disclosure was describe what Applicants felt was their preferred approach to ad delivery, while expressly noting that changes to the preferred approach might be made in the form, construction, procedure and arrangement of its various elements and steps without departing from its spirit or scope ('156 discl. col. 4, lns. 5-7).

Yet additionally, in order for the Examiner to deny Applicants the benefit of the filing date of their '156 application, the Examiner must restrict the claim scope available to Applicants' '156 disclosure to the expressly noted preferred embodiment presented in the '156 disclosure in violation of the prohibition the Federal Circuit has established regarding improper restriction of claim scope to merely the preferred or single embodiment presented in a patent application or to claimed matter including only all features of the disclosed embodiment. Regarding the Federal Circuit prohibition against denying conceivable and possible future embodiment claim scope to an application *see, e.g.,* above discussed cases, *Cordis Corp. v. Medtronic AVE Inc.*, 67 USPQ2d 1876, 1886 (Fed. Cir. 2003); *Amgen Inc. v. Hoechst Marion Roussel Inc.*, 65 USPQ2d 1385, 1395; (Fed. Cir. 2003); *Rexnord Corp. v. Laitram Corp.*, 60 USPQ2d 1851, 1856 (Fed. Cir. 2001); *SRI Int'l v. Matsushita Elec. Corp. of America*, 227 USPQ 577, 586 (Fed. Cir. 1985) (*en banc*). Regarding the Federal Circuit prohibition against denying claim scope other than the disclosed preferred embodiment to an application, *see, e.g.,* above discussed cases, *Liebel-Flarsheim Co. v. Medrad Inc.*, 69 USPQ2d 1801, 1807 (Fed. Cir. 2004); *Lampi Corp. v. American Power Products, Inc.*, 56 USPQ2d 1445, 1455 (Fed. Cir. 2000); *Laitram Corp. v. Cambridge Wire Cloth Co.*, 9 USPQ2d

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1289, 1299 (Fed. Cir. 1988); and *SRI Int'l v. Matsushita Elec. Corp. of America*, 227 USPQ 577, 586 (Fed. Cir. 1985) (*en banc*). And, regarding the Federal Circuit prohibition against denying claim scope other than exactly as described in a disclosure, *see, e.g.*, above discussed cases, *All Dental Prodx LLC v. Advantage Dental Products Inc.*, 64 USPQ2d 1945, 1948 (Fed. Cir. 2002); *Eiselstein v. Frank*, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *Moba B.V. v. Diamond Automation Inc.*, 66 USPQ2d 1429, 1439 (Fed. Cir. 2003) (citing *Union Oil Co. of Cal. v. Atlantic Richfield Co.*, 54 USPQ2d 1227, 1232 (Fed. Cir. 2000); and *In re Hayes Microcomputer Prods., Inc.*, 25 USPQ2d 1241, 1245 (Fed. Cir. 1992). Based on the attendant facts in Applicants' case, for example, the predictable character of the computerized network communication art of Applicants' subject invention; and the established understanding of those skilled in the art regarding that technology; and the facts concerning what those skilled in the art would understand any of Applicants' prior applications; e.g., the '156 application, to disclose; and the facts concerning Applicants' express incorporation in their disclosure of understanding in the computerized network communication art as of at least their '156 application filing date with respect to subject matter concerning Applicants' teaching in the form of the Stallings, *Data and Computer Communications*, text; and the facts concerning absence of either concessions or disclaimers by the Applicants regarding any of the subject matter relating to the simplified form or preferred buffered form of the ad delivery system and in view of the noted Federal Circuit case, Applicants' submit that it is improper for the Examiner to exclude to at least Applicants' '156 application disclosure claim scope including the simplified approach to targeted ad delivery.

Therefore, Applicants would respectfully submit, that based at least on the preceding discussions, it is apparent that the written description of the '156 application, which is carried forward in all of Applicants' following applications, embraces the

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simplified approach of targeted ad delivery; i.e., the simplified approach is, in fact, a part of Applicants' invention of the pre-fetch approach - and - those skilled in the network art upon reviewing Applicants' '156 patent application at the time the application was filed would have so understood that fact. Accordingly, Applicants also respectfully submit that the Examiner's denial of Applicants' '156 application's filing date to the current application and its claimed subject matter is improper and must be withdrawn.

4. The Examiner has failed to understand, and, indeed, has mis-described the technological elements expressly taught in the disclosures of Applicants' '156 and following applications, which elements and associated teachings necessarily communicate to and would be understood by those skilled in the art at the time of respective filing of Applicants' '156 and following applications as comprehending and encompassing the currently claimed subject matter; i.e., the noted simplified approach to targeted ad delivery. As a direct result of this failure to appreciate and understand the express disclosure of at least Applicants' '156 application, the Examiner's had not established a *prima facie* against Applicants' '156 application's adequacy to support the simplified approach of targeted ad delivery there disclosed.

For example, and with regard to claims 1-12, 13-18, 32-37, 41-46, and 47-49; (Claim Group A) the Examiner contends the written descriptions of Applicants' prior specifications are inadequate on the grounds that the "simplified," targeted-ad delivery approach is not expressly, implicitly, or inherently disclosed - because - "[t]he [prior] specification ... does not ... [suggest] the 'high system function' [*sic*] selects an advertiser host connected via the gateway 210 to provide advertisement content in response to a request from a user reception system" (Action, p. 6).

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In fact, however, Applicants' '156 application discloses and suggests that high function system 110 receives request messages from respective user reception systems 400 for ad information, and, supplies ad information in response to the requesting reception system 400, that ad information identifying ad content, for example, located across gateway 210, the processing of such ad information originating a message across the gateway 210 for ad content and its supply to the requesting user reception system 400. More specifically, Applicants' '156 application indicates a message ('156 discl. col. 22, ln. 29 - col. 23, ln. 46) from a respective reception system 400 requesting ad information is sent to high function system 110 ('156 discl. col. 92, lns. 1-6); and a targeted ad object id is sent in response from high function system 110 to the requesting reception system 400 ('156 discl. col. 92, lns. 6-9), the targeted ad object including ('156 discl. col. 14, lns. 34-44) a "program call segment" ('156 discl. col. 14, ln. 48 - col. 15, ln. 2) having a program including, for example, the interpretive language verb "SEND" ('156 discl. col. 89, lns. 36-53; col. 63, ln. 52 - col. 64, ln. 6) to originate a message, and a verb "RECEIVE" ('156 discl. col. 89, lns. 36-53; col. 62, lns. 27-40) to accept a reply to the message across a gateway ('156 discl. col. 35, ln. 58 - col. 39, ln. 18) for targeted ad content.

Additionally, with regard to Claim Group A, the examiner nakedly contends: "[t]here is no disclosure of what exist [sic] on the outside network [over gateway 210]" (Action, p. 6).

Here, however, not only does the Examiner assert an unfounded and erroneous characterization of what Applicants' '156 application actually does expressly disclose, but also, the Examiner asserts and imposes an improper and unauthorized written description test. As discussed at length above at least in sections II, B, 1-7, concerning the true legal procedures for evaluating written description adequacy to support claimed matter, written

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description evaluation as established by the Court of Appeals for the Federal Circuit turns *not* on what a specification *expressly* discloses, but rather, on what those skilled in the art conclude the specification embraces, *see, In re Alton*, 37 USPQ2d 1578, 1584 (Fed. Cir. 1996) ("If a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate written description requirement is met."). With regard to the Examiner's erroneous characterization of what Applicants' '156 application actually does expressly discloses, the Examiner here erroneously asserts Applicants' '156 application does not include any express disclosure concerning what exists on the other side of described gateway system 210. However, as a reading of Applicants' '156 application clearly shows, Applicants, in fact, expressly states that gateway system 210 connects network 10 "to other sources of information and data; e.g., other computer systems" ('156 discl. col. 4, lns. 35-42). Additionally, Applicants' '156 application expressly states that the Applicants' Data Interchange Architecture (DIA) which support system messaging "provides common data structure between applications run at RS 400 units and applications that may be run on external computer networks; e.g. Dow Jones Services, accessed through gateway 210" ('156 discl. col. 22, lns. 53-57). Still further, Applicants' '156 application expressly teaches that messages passed over gateways 210, "between the network and external parties occurs between two applications; i.e., the server 205 [and a] network message handler (NMH). The server Switch 205 is an application which is written and maintained by network 10 and resides on it. The message handler resides on the other side of gateway 210 from network 10 and may be written and maintained by the external party; i.e., suppliers of information to network 10 such as Dow Jones" ('156 discl. col. 35, ln. 58 - col. 39, ln. 18).

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Continuing with regard to Claim Group A, notwithstanding the above-described express disclosure in Applicants' '156 application concerning communication between system elements supporting Applicants' possession of the simplified approach to user-targeted ad delivery as of the filing of their '156 application, the Examiner asserts, without offer of proof, that "[t]here is no written description [in Applicants' prior applications] that a request from the user system is ever received by the 'high function system' 110 or a 'gatewayed' third-party host. Any request for content not already on the user system is fulfilled by the cache/concentrator 302 and file server 205" (Action, bottom p. 6 - p. 7).

Here also, the Examiner asserts an improper *express-description* test, instead of the establish what-the-disclosure-embraces-viewed-by-skill-in-the-art test, again, *see, In re Alton*, 37 USPQ2d at 1584 - and - advances unfounded and erroneous descriptions of what Applicants' '156 application, in fact, expressly discloses. As pointed out above, Applicants' '156 application expressly teaches that user reception systems 400 and high function system 110 are network connected and directly communicate with one another at least for the purpose of respective reception systems 400 requesting targeted ad information from high function system 110, and high function system 110 responding by sending user-targeted ad information to the requesting reception system 400 ('156 discl. col. 92, lns. 1-9). Still further, and again, as noted above, Applicants' '156 application expressly teaches that respective user reception systems 400 are network connected and communicate over gateway system 210 with other sources of information and data; e.g., other computer systems ('156 discl. col. 4, lns. 35-42) such as Dow Jones ('156 discl. col. 22, lns. 53-57; col. 35, ln. 58 - col. 39, ln. 18); and that such communication are expressly taught to be capable of arising from advertising objects (ad objects, '156 discl. col. 14, lns. 34-44; program call segments, col. 14, ln. 48 - col. 15, ln. 2) that are capable of initiating messages (SEND, '156

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discl. col. 89, lns. 36-53; col. 63, ln. 52 - col. 64, ln. 6) and receiving message responses (RECEIVE, '156 discl. col. 89, lns. 36-53; col. 62, lns. 27-40) across a gateway ('156 discl. col. 35, ln. 58 - col. 39, ln. 18) for targeted ad content.

Still further, the Examiner erroneously asserts with regard to Claim Group A that Applicants' disclosure "teaches away" from the simplified approach because "[t]he disclosed system was aimed at solving the issues of low bandwidth and latency in retrieving data over slow modem link at the user reception systems" (Action, p. 6).

This assertion is also unfounded. As pointed out earlier with regard to targeted ads, Applicants' system architecture and operation, *inter alia*, are aimed at displaying application-independent, user-targeted ads at user reception systems 400 because Applicants believed such ads would be more favorably received by users, thus contributing to the likelihood the Service would be commercial successful, ads being a source of commercial support for the Service. As part of the effort to display such ads, a further aim of the Applicants was to deliver the application-independent, user-targeted ads to respective reception systems 400. That "delivery aim" was of prominent importance to the display objective and was addressed by enabling reception systems 400 to receive ad information from; e.g., high function system 110, and gateway system 210, by means of network communication as above and hereafter described. Both the simplified approach and the pre-fetch approach are directed to that aim, in that both the simplified approach and the pre-fetch approach feature network connection and direct communication, again, as above and hereafter described. In fact, the only difference between the simplified approach and the pre-fetch approach is that the pre-fetch approach enhance; i.e., improves, performance by reducing response time with the inclusion of an ad buffer. However, while the buffer is preferred; i.e., desirable, it is not essential to the ability to deliver targeted ads.

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The two approach share the same network arrangement, and, in fact, the simplified approach is a applicant-devised precursor of the pre-fetch approach. The pre-fetch approach does not "teach away" from the simplified approach as the Examiner contends, rather it enhances it, and that fact would be clearly appreciated by those skilled in the art.

With regard to claims 19-31, 38-40 and 51; (Claim Group B), the Examiner, here also without any offer of proof, contends that Applicants' prior specifications do not expressly, implicitly, or inherently discloses the simplified targeted ad delivery approach because "[t]here is no written description suggesting that the 'high function system' 110 ever receive any user request. There is no written description suggesting that the 'high function system' 110 ever receive a user request based a *[sic]* location designation and to response *[sic]* with advertising content" (Action, p. 8).

Once again, the Examiner's asserts are unfounded and erroneous descriptions of what Applicants' '156 application, in fact, expressly describes. As explained above, Applicants' '156 application expressly teaches that user reception systems 400 and high function system 110 are network connected and directly communicate with one another ('156 discl. col. 22, ln. 29 - col. 23, ln. 46) at least for the purpose of respective reception systems 400 requesting targeted ad information from high function system 110, and high function system 110 responding by sending user-targeted ad information to the requesting reception system 400 ('156 discl. col. 92, lns. 1-9). Applicants' '156 disclosure; for example, expressly states:

Whenever the [reception system 400] advertisement queue has more empty positions than replenishment threshold, a transaction is made to the advertisement queue application in high function system 110 shown in FIG. 2, via [reception system 400] object/communications manager interface 433 for a number of advertisement object id's equal to the threshold. A response

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message [from high function system 110] includes a list of advertisement object id's, which [reception system 400] ad manager 442 enqueues.

'156 Disclosure col. 92, lns. 1-9.

Still further, Applicants' '156 application expressly teaches that in the preferred, pre-fetch; i.e., buffered, approach, the message from a respective reception system 400 requesting targeted ad information arises from an ADSLOT call occurrence that reduces the pre-fetched; i.e., buffered, ad id supply below a preset value ('156 discl. col. 91, ln. 61 - col. 92, ln. 9). As would be appreciated by those skilled in the art, the ADSLOT call that reduces the ad buffer is the precipitating event that directly causes reception system 400 to message to high function system 110 for ad information - stated otherwise - the ADSLOT call is the event certain that depletes the buffered ad id supply below the preset level and triggers the request message to high function system 110 ('156 discl. col. 91, lns. 61-68). Accordingly, the Examiner's assertions notwithstanding, Applicants' '156 application, in fact, at least suggests that the high function system 110 receive a user request based on an ADSLOT; i.e., location designation, event, and high function system 110, as previously described, responds by sending ad information to the respective reception system 400.

Continuing with regard to Claim Group B, notwithstanding the above-described express disclosure in Applicants' '156 application concerning communication between system elements supporting Applicants' possession of the simplified approach to user-targeted ad delivery as of the filing of their '156 application, the Examiner asserts that "[f]ig. 2 and the disclosure clearly show that the 'high function system' 110 only *[sic]* connected to File server 205. There is no communication link from the user reception system to the 'high function system' 110. All content requests from the user receptions are fulfilled by the cache/connector 302 or server 205." (Action, p. 8).

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Here again, the Examiner's assertions regarding the express disclosure of Applicants' prior applications are unfounded and erroneous. Indeed, not only do the Examiners assertions manifest a gross misunderstanding of what Applicants' prior applications actually expressly disclose, but also, the Examiner's assertions lack an appreciation of basic network communication technology. As pointed out above, Applicants' '156 specification expressly discloses and teaches that the elements of Applicants' system elements are network connected and communicate directly ('156 discl. col. 22, ln. 24 - col. 39, ln. 18). As the '156 disclosure states:

In accordance with the invention, to facilitate message exchange internally, and through gateway 210 to entities externally to network 10, a protocol termed the "Data Interchange Architecture" (DIA) is used to support the transport and interpretation of information. More particularly, DIA enables: communications between RS 400 units; separation of functions between network layers 100, 200, 300 and 401; consistent parsing of data; an "open" architecture for network 10; downward compatibility within the network; compatibility with standard industry protocols such as the IBM System Network Architecture; Open Systems Interconnections standard; support of network utility sessions; and standardization of common network and application return codes.

'156 Disclosure, col. 22, lns. 29-59.

Moreover, with regard to the Examiner's reference to Applicants' Fig. 2, as understood by those skilled in the network art, because network communication employing multilayer protocols such as SNA, OSI, TCP/IP and Applicants' DIA rely on use of network addressing and routing, single-wire network diagrams are understood to embrace the existence of direct communication channels between multiple network elements. See e.g., W. Stallings, *Data and Computer Communications*, included herewith; at least, at chapters 12, 14.

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Yet additionally, and as emphasized above, Applicants' '156 disclosure expressly teaches that user reception systems 400 and high function system 110 directly communicate with each another; for example, regarding reception system 400 requests to high function system 110, for ad information and its supply, the '156 disclosure states:

Whenever the [reception system 400] advertisement queue has more empty positions than replenishment threshold, a transaction is made to the advertisement queue application in high function system 110 shown in FIG. 2, via [reception system 400] object/communications manager interface 433 for a number of advertisement object id's equal to the threshold. A response message [from high function system 110] includes a list of advertisement object id's, which [reception system 400] ad manager 442 enqueues.

'156 Disclosure col. 92, lns. 1-9.

C. Demand Under 37 CFR §1.608(b) and Rejections under 35 USC §§ 102, 103 Improper

1. In view of the above discussion regarding the Examiner's erroneous and unfounded factual analysis of Applicants' prior disclosures and the Examiner's mistaken application of the law regarding the adequacy of a written description to support claimed subject matter, and Applicants' reply thereto, Applicants would respectfully submit that the Examiner's denial of at least Applicants' '156 application July 28, 1989 filing date to the current application and its currently claimed subject matter is improper and must be withdrawn.

Still further, Applicants would respectfully submit that in view of at least the above discussion concerning the Examiner's improper analysis of the availability of Applicants' prior application filing dates, and Applicants' reply, Applicants' current application and its currently claimed subject matter are entitled to at least the July 28, 1989 filing date of Applicants' '156 application. Accordingly, the effective filing date of the Applicants'

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current application is *not* more than three (3) months *after* the effective filing date of the patent Applicants seek declaration of an interference with, *but rather*, the effective filing date of Applicants' current application is at least *seven (7) years before* the effective filing date of the patent Applicants seek declaration of an interference with. In view of these facts, the Examiner's demand that Applicants submit a showing pursuant to Section 1.608(b) of the patent regulations is improper and must be withdrawn.

Additionally, since the effective filing date of Applicants' current application is at least seven (7) years before the effective filing date of the patent Applicants seek declaration of an interference with, Applicants' rely at least on the July 28, 1989 effective filing date of their '156 application to establish conception and constructive reduction to practice of the currently claimed subject matter. As established by the Court of Claims and Patent appeals, and approved by the Federal Circuit, "the act of filing the United States application has the legal effect of being, constructively at least, a simultaneous conception and reduction to practice of the [claimed] invention." *See Yasuko Kawai v. Metlesics*, 178 USPQ 158, 162 (CCPA 1973). *See also, Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 87 (Fed. Cir. 1986) ("constructive reduction to practice occurs when a patent application on the claimed invention is filed"). As a result, Applicants would note that there is no need for proof or corroboration of the claimed subject matter. As explained in *Yasuko Kawai*, 178 USPQ at 163, "the written specification in the application is the evidence proving the invention of that which is reduced to practice." In view of this, Applicants in the current application need not provide evidence of either conception or actual reduction to practice. Applicants, therefore, request that an interference be declared between their current application and U.S. patent 5,948,061, and found in Applicants' favor.

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With regard to the Examiner's rejection of Applicants' pending claims 1-51 pursuant to Section 102 (e) of the patent statute as being anticipated by Merriman et al. U.S. patent 5,948,061, Applicants would respectfully submit that in view of at least the July 28, 1989 effective filing date of there current application and claimed subject matter and Applicants' conception and constructive reduction to practice established as of that effective filing date by virtue of Applicants' '156 application, the Examiner rejection of pending claims 1-51 pursuant to Section 102(e) as being anticipated by Merriman et al. is improper and must be withdrawn.

Concerning the Examiner's rejection of Applicants' pending claims 1, 3, 7, 13, 15, 19, 20, 23, 29, 32, 34, 38 41, 43, 47, 48 50 and 51 pursuant to Section 102(b) as being anticipated by the Kohda et al. article *Ubiquitoussss Advertising on the WWW; Merging Advertisement on the Browse* noted as published in 1996, Applicants would respectfully submit that in view of at least the July 28, 1989 effective filing date of there current application and claimed subject matter by virtue of Applicants' '156 application, the Examiner rejection of pending claims 1, 3, 7, 13, 15, 19, 20, 23, 29, 32, 34, 38 41, 43, 47, 48 50 and 51 pursuant to Section 102(b) as being anticipated by Merriman et al. is improper and must be withdrawn.

Finally, as to the Examiner's rejection of Applicants' pending claims 2, 4, 8, 10, 14, 16, 24, 26 33, 35, 42, 44, 49 and 48 pursuant to Section 103(a) of the patent statute as being unpatentable in view of the noted Kohda et al. publication, Applicants would respectfully submit that in view of at least the July 28, 1989 effective filing date of their current application and claimed subject matter, and Applicants' conception and constructive reduction to practice established as of that effective filing date by virtue of Applicants' '156 application, the Examiner rejection of pending claims 2, 4, 8, 10, 14, 16, 24, 26 33, 35, 42, 44,

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49 and 48 pursuant to Section 103(a) as being unpatentable in view of the Kohda et al. publication is improper and must be withdrawn.

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IV Conclusion

The Examiner has failed to establish a *prima facie* case upon which to deny Applicants' right to the filing date of at least their '156 application because the Examiner has erroneously and incorrectly described Applicants' '156 disclosure and the targeted ad delivery facility there disclosed, and thereby, the Examiner has failed to either demonstrate the claimed subject matter; i.e., the simplified approach to targeted ad delivery, is outside the scope of the '156 disclosure, or, that one of ordinary skill in the art would not have consider the '156 disclosure adequate to support the currently claimed simplified approach to targeted ad delivery. See, *In re Alton*, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996). Further, in view of *Alton* and other Federal Circuit authority, the Examiner is obliged to present evidence or reasons why persons skilled in the art would not recognize in at least that the '156 application, the disclosure of the simplified approach to targeted ad delivery. And, yet further, in view of that failure, as a matter of law Applicants' '156 written description must be deemed adequate to support the currently claimed simplified approach to targeted ad delivery, and, the Examiner's denial of the '156 application's July 28, 1989 filing date to the current application and claimed simplified approach to targeted ad delivery, must be withdrawn. See *In re Oetiker*, at 1444 citing *In re Grabiak*, 226 USPQ 870, 873 (Fed. Cir. 1985); and *In re Rinehart*, 189 USPQ 143 (CCPA 1976).

The Examiner has failed to apply and declined to consider the proper legal test for determining the adequacy of a written description for claimed matter under Section 112, ¶1 in connection with a request for the filing date of an earlier application. Instead of applying the standard for a written description adopted and repeatedly articulated by the Court of Appeals for the Federal Circuit (Federal Circuit), see, *In re Alton*, 37 USPQ2d 1578,

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1584 (Fed. Cir. 1996) above discussed, the Examiner has applied his own test; i.e., a test that requires for a written description to be adequate, the written description must *expressly describe* the subject matter claimed. However, the Federal Circuit has specifically rejected such an express, written description test as the Examiner asserts, and, rather, has authorized and approved a test that turns on whether a written description conveys to those skilled in the art that the applicants were in possession of the claimed matter as of the application filing date.

Applicants would respectfully submit that the express teaching of at least their '156 application, comprehends; i.e., embraces, the "simplified" approach to delivery of user-targeted ads; and that the simplified approach to delivery of user targeted ads is, in fact, expressly included in, and, an applicant-devised precursor of the preferred, "pre-fetch"; i.e., buffered, approach presented in their '156 application, the principal elements of the simplified approach; i.e., user reception systems 400 exclusive of the pre-fetch buffer; high function system 110; and gateway system 210 being the same in structure and function as in the pre-fetch approach - stated otherwise - the simplified approach is, in fact, a part of Applicants' invention of the pre-fetch approach, the pre-fetch buffer being preferred in, but, not essential to, the ability to deliver targeted ads, and, that teaching would have been clearly understood by those skilled in the network art and considered possessed by Applicants at the time Applicants' filed the '156 application - thereby - rendering the written description of the '156 application, which written description is carried forward in all subsequent applications, adequate under the law to make at least the filing date of the '156 application, available to the current application and its claimed subject matter. In support of those conclusions, Applicants offer as evidence the respective disclosures of their prior applications and the content of *Data and Computer Communications*, by William Stallings, Macmillian Publishing Company (1985) which is

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incorporated by reference in Applicants' '156 application and subsequent applications, the Stallings book also being offered in its entirety in this reply as evidence of skill in the art indicating comprehension by those skilled in the art that based on Applicants' '156 disclosure, the simplified approach was in Applicants' possession at the time of filing of the '156 application on July 28, 1989, a copy of the Stallings book being attached hereto and made a part hereof. Accordingly, Applicants further submit that the Examiner's denial of Applicants' '156 application's filing date to the current application and its claimed subject matter is improper and must be withdrawn.

As seen from the perspective of operation of user reception system 400, high function system 110 and gateway system 210, owing to their network connection and their ability to exchange information and data in accord with Applicants' disclosed use of communication standards; i.e., SNA, OSI (see, e.g., '156 discl. col. 22, ln. 8 - col. 39, ln. 18), these elements remain in direct communication and operate in substantially the way exclusively of the ad buffer, that is, whether the ad buffer is present in the pre-fetch approach, or whether the ad buffer is removed in the simplified approach. And those facts would have been apparent from the express disclosure of '156 application to one skilled in the art at the time the '156 application was filed, since the general operation and capability of communication standards noted in Applicants' '156 disclosure were understood by those skilled in the art as evidenced by the teachings disclosed in at least chapters 12 and 14 of *Data and Computer Communications*, by W. Stallings, published in 1985, a copy of which book is attached here to and made a part hereof.

Still further, it is apparent for Applicants' '156 disclosure that Applicants have *not* used any words or expressions demonstrating or indicating an intention to concede, yield or disclaim the simplified approach to targeted ad delivery from use in their system. And,

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the Examiner has offered no evidence of any such concession or disclaimer by Applicants of the simplified approach. Rather, what Applicants did do in the '156 disclosure was describe what Applicants felt was their preferred approach to ad delivery, while expressly noting that changes to the preferred approach might be made in the form, construction, procedure and arrangement of its various elements and steps without departing from its spirit or scope ('156 discl. col. 4, lns. 5-7).

Yet additionally, in order for the Examiner to deny Applicants the benefit of the filing date of their '156 application, the Examiner must restrict the claim scope available to Applicants' '156 disclosure to the expressly noted preferred embodiment presented in the '156 disclosure in violation of the prohibition the Federal Circuit has established regarding improper restriction of claim scope to merely the preferred or single embodiment presented in a patent application or to claimed matter including only all features of the disclosed embodiment. Further, based on the attendant facts in Applicants' case, for example, the predictable character of the computerized network communication art of Applicants' subject invention; and the established understanding of those skilled in the art regarding that technology; and the facts concerning what those skilled in the art would understand any of Applicants' prior applications; e.g., the '156 application, to disclose; and the facts concerning Applicants express incorporation in their disclosure of understanding in the computerized network communication art as of at least their '156 application filing date with respect to subject matter concerning Applicants' teaching in the form of the Stallings, *Data and Computer Communications*, text; and the facts concerning absence of either concessions or disclaimers by the Applicants regarding any of the subject matter relating to the simplified form or preferred buffered form of the ad delivery system and in view of the noted Federal Circuit case, Applicants' submit that is improper for the

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Examiner to exclude to at least Applicants' '156 application disclosure claim scope including the simplified approach to targeted ad delivery.

Therefore, Applicants would respectfully submit, that based at least on the preceding discussions, it is apparent that the written description of the '156 application, which is carried forward in all of Applicants' following applications, embraces the simplified approach of targeted ad delivery; i.e., the simplified approach is, in fact, a part of Applicants' invention of the pre-fetch approach - and - those skilled in the network art upon reviewing Applicants' '156 patent application at the time the application was filed would have so understood that fact. Accordingly, Applicants also respectfully submit that the Examiner's denial of Applicants' '156 application's filing date to the current application and its claimed subject matter is improper and must be withdrawn.

The Examiner has failed to understand, and, indeed, has mis-described the technological elements expressly taught in the disclosures of Applicants' '156 and following applications, which elements and associated teachings necessarily communicate to and would be understood by those skilled in the art at the time of respective filing of Applicants' '156 and following applications as comprehending and encompassing the currently claimed subject matter; i.e., the noted simplified approach to targeted ad delivery. As a direct result of this failure to appreciate and understand the express disclosure of at least Applicants' '156 application, the Examiner's had not established a *prima facie* against Applicants' '156 application's adequacy to support the simplified approach of targeted ad delivery there disclosed.

In view of the above discussion regarding the Examiner's erroneous and unfounded factual analysis of Applicants' prior disclosures and the Examiner's mistaken application of the law regarding the adequacy of a written description to support claimed subject

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matter, and Applicants' reply thereto, Applicants would respectfully submit that the Examiner's denial of at least Applicants' '156 application July 28, 1989 filing date to the current application and its currently claimed subject matter is improper and must be withdrawn.

Still further, Applicants would respectfully submit that in view of at least the above discussion concerning the Examiner's improper analysis of the availability of Applicants' prior application filing dates, and Applicants' reply, Applicants' current application and its currently claimed subject matter are entitled to at least the July 28, 1989 filing date of Applicants' '156 application. Accordingly, the effective filing date of the Applicants' current application is *not* more than three (3) months *after* the effective filing date of the patent Applicants seek declaration of an interference with, *but rather*, the effective filing date of Applicants' current application is at least *seven (7) years before* the effective filing date of the patent Applicants seek declaration of an interference with. In view of these facts, the Examiner's demand that Applicants submit a showing pursuant to Section 1.608(b) of the patent regulations is improper and must be withdrawn.

Additionally, since the effective filing date of Applicants' current application is at least seven (7) years before the effective filing date of the patent Applicants seek declaration of an interference with, Applicants' rely at least on the July 28, 1989 effective filing date of their '156 application to establish conception and constructive reduction to practice of the currently claimed subject matter. As established by the Court of Claims and Patent appeals, and approved by the Federal Circuit, "the act of filing the United States application has the legal effect of being, constructively at least, a simultaneous conception and reduction to practice of the [claimed] invention." *See Yasuko Kawai v. Metlesics*, 178 USPQ 158, 162 (CCPA 1973). *See also, Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231

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USPQ 81, 87 (Fed. Cir. 1986) ("constructive reduction to practice occurs when a patent application on the claimed invention is filed"). As a result, Applicants would note that there is no need for proof or corroboration of the claimed subject matter. As explained in *Yasuko Kawai*, 178 USPQ at 163, "the written specification in the application is the evidence proving the invention of that which is reduced to practice." In view of this, Applicants in the current application need not provide evidence of either conception or actual reduction to practice. Applicants, therefore, request that an interference be declared between their current application and U.S. patent 5,948,061, and found in Applicants' favor.

With regard to the Examiner's rejection of Applicants' pending claims 1-51 pursuant to Section 102 (e) of the patent statute as being anticipated by Merriman et al. U.S. patent 5,948,061, Applicants would respectfully submit that in view of at least the July 28, 1989 effective filing date of there current application and claimed subject matter and Applicants' conception and constructive reduction to practice established as of that effective filing date by virtue of Applicants' '156 application, the Examiner rejection of pending claims 1-51 pursuant to Section 102(e) as being anticipated by Merriman et al. is improper and must be withdrawn.

Concerning the Examiner's rejection of Applicants' pending claims 1, 3, 7, 13, 15, 19, 20, 23, 29, 32, 34, 38 41, 43, 47, 48 50 and 51 pursuant to Section 102(b) as being anticipated by the Kohda et al. article *Ubiquitoussss Advertising on the WWW; Merging Advertisement on the Browse* noted as published in 1996, Applicants would respectfully submit that in view of at least the July 28, 1989 effective filing date of there current application and claimed subject matter by virtue of Applicants' '156 application, the Examiner rejection of pending claims 1, 3, 7, 13, 15, 19, 20, 23, 29, 32, 34, 38 41, 43, 47, 48 50 and 51 pursuant to Section 102(b) as being anticipated by Merriman et al. is improper and must be withdrawn.

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Finally, as to the Examiner's rejection of Applicants' pending claims 2, 4, 8, 10, 14, 16, 24, 26 33, 35, 42, 44, 49 and 48 pursuant to Section 103(a) of the patent statute as being unpatentable in view of the noted Kohda et al. publication, Applicants would respectfully submit that in view of at least the July 28, 1989 effective filing date of their current application and claimed subject matter, and Applicants' conception and constructive reduction to practice established as of that effective filing date by virtue of Applicants' '156 application, the Examiner rejection of pending claims 2, 4, 8, 10, 14, 16, 24, 26 33, 35, 42, 44, 49 and 48 pursuant to Section 103(a) as being unpatentable in view of the Kohda et al. publication is improper and must be withdrawn.

In closing, Applicants would respectfully note, that in the event the Examiner has any questions regarding Applicants' remarks here or otherwise concerning the matters considered, Applicants' attorney would be pleased to meet with the Examiner at his convenience for a further discussion of them.

Dated: July 30, 2004

Respectfully submitted,


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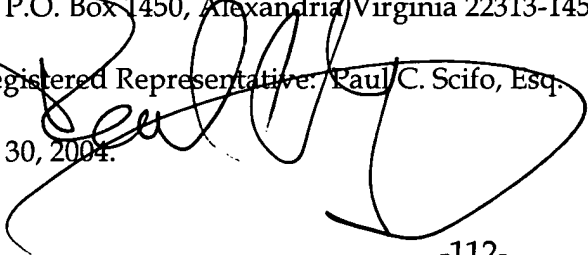
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Name of Registered Representative: Paul C. Scifo, Esq.

Signature: 

Date: July 30, 2004.